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IN THE

Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-1314

JEFFREY SNYDER, d/b/a J.S.N.Y.
and ETNA PRODUCTS CO., INC.,

Petitioners,

v.

L. BATLIN & SON, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

ROBERT C. FABER,
Attorney for Petitioner.

OSTROLENK, FABER, GERB & SOFFEN
260 Madison Avenue
New York, New York 10016
(212) 685-8470

Adams Press Corp., 11 Commerce Street, Newark, N. J. 07102—(201) 623-8611

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v.

L. BATLIN & SON, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioners, Jeffrey Snyder and Etna Products Co., Inc., respectfully pray that a Writ of Certiorari issue to review the Judgment and Opinion of the United States Court of Appeals for the Second Circuit entered in this proceeding on April 12, 1976.

Opinions Below

The Majority and Dissenting Opinions of the Second Circuit Court of Appeals, sitting *en banc,* are reported at F.2d , 189 USPQ 753 (2 Cir. April 12, 1976) and are found at Appendix A hereto. The aforsesaid Majority Decision was a reversal of a previous Decision by a three judge panel of the Second Circuit Court of Appeals, in which there were also Majority and Dissenting Opinions. These Opinions are reported at F.2d , 187 USPQ 721 (2 Cir. October 24, 1975), and are found at Appendix B hereto. The earlier Majority Decision of the Court of Appeals was, in turn, a reversal of the Decision of the United States District Court for the Southern District of New York, contained in an Opinion reported at 394 F. Supp. 1389, 187 USPQ 91 (S.D.N.Y. May 12, 1975) and found at Appendix C hereto. The Order of the District Court, pursuant to its Opinion and from which the Appeal was taken to the Court of Appeals, entered May 16, 1975, is not reported and is found at Appendix D hereto*.

In addition, the United States Court of Appeals for the Second Circuit on June 24, 1975 Ordered a Stay of the Order of the United States District Court for the Southern District of New York that had been entered May 16, 1975. This Stay Order of the Court of Appeals is unpublished. A copy of the Stay Order of the Court of Appeals is found at Appendix E hereto. The United States Court of Appeals for the Second Circuit on July 9, 1975 issued an Order Dissolving the Stay that had been

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* An opinion in the companion case, *Etna Products Co.* v. *E. Mishan & Sons,* 75 Civ. 428 (S.D.N.Y. February 13, 1975) is unreported and is found at Appendix K hereto.

granted by that same Court on June 24, 1975. This Order is also unpublished. A copy of this Order is found at Appendix F.

Jurisdiction

The judgment of the United States Court of Appeals for the Second Circuit was entered on April 12, 1976. This judgment followed a rehearing *en banc* of an earlier decision of the same Court of Appeals. This Petition for Certiorari is being filed within ninety days of the final judgment of the Court of Appeals for the Second Circuit. The jurisdiction of this Court is invoked under 62 Stat. 928, 28 U.S.C., Sec. 1254(1) (1948).

Questions Presented

1. Is there a standard of "true artistic skill" for determining originality of a copyrighted work?

2. May a judge of the United States District Court or of the United States Court of Appeals assess the artistic merit of a work to determine if it has sufficient originality to be copyrightable?

3. Where a skilled artist and designer uses a three-dimensional work in the public domain as his inspiration in the creation of a new sculpture and where there is considerable skilled artistic effort in the new sculpture and where numerous features of the new sculpture differ from the public domain work, may a Court determine that such new sculpture does not have sufficient originality to be a copyrightable work?

4. Is petitioner's three-dimensional work "original" within the meaning of that term as required for that work to be copyrightable?

Constitutional Provision and Statute

The United States Constitution, Article 1, Section 8, Clause 8:

> "To Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Wrightings and Discoveries."

Copyright Act, Sec. 5, 61 Stat. 652, 17 U.S.C., Sec. 5 (1947):

> "The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs: . . .
>
> "(g) Works of art; models or designs for works of art;
>
> "(h) Reproductions of a work of art . . .
>
> "The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title nor shall any error in classification invalidate or impair the copyright protection secured under this title."

Statement of the Case

In this action, Respondent is seeking *inter alia,* a Declaration as to the invalidity of Petitioner's copyright. Jurisdiction over this action in the Federal Courts is predicated upon 62 Stat. 928, 28 U.S.C. Sections 2201, 2202 and 1338 (1948).

Cast metal savings banks incorporating an Uncle Sam figure standing atop a decorated, box-like platform have

long been in the public domain. A typical example of the prior metal Uncle Sam bank is in evidence in this proceeding as physical Exhibit 1.

Petitioner Etna Products Co., Inc. is engaged in the business of importing and selling novelty items such as the Uncle Sam bank. Jeffrey Snyder is an officer of Etna and commissions the design and sculpting of novelty items which Etna thereafter markets. In January, 1974, Jeffrey Snyder saw one version of an 11 inch high metal Uncle Sam bank. As the item appeared quite timely for marketing in connection with the U.S. Bicentennial, Jeffrey Snyder purchased it.

In April, 1974, while Jeffrey Snyder was in Hong Kong, he asked his Hong Kong buying agent whether it could design and produce a new plastic Uncle Sam bank for him, inspired by the metal bank. A skilled designer and mold maker in Hong Kong was selected by the buying agent. Then (a) sketches were made during a conference among Jeffrey Snyder, his buying agent and the designer of a proposed reduced size, plastic material Uncle Sam bank, that was to be inspired by the antique metal Uncle Sam bank. (b) A 10 inch high clay model of the proposed article was thereafter sculpted. (c) During a later meeting, Jeffrey Snyder, the buying agent and the mold maker decided to further modify the design and to further reduce the height of the model to 9 inches. (d) A 9 inch tall prototype was accordingly sculpted. (e) After Jeffrey Snyder approved the prototype, its design was utilized for preparation of the mold employed in the production of Snyder's eventually copyrighted, commercial work. An example of the copyrighted plastic bank is in evidence as Exhibit 2 herein.

Both of Respondent Batlin's expert witness (at the Appendix in the Court of Appeals p. 65, li. 5-p. 66, li. 8)

and Petitioner Snyder's expert witness, (at the Appendix in the Court of Appeals pp. 93-95; p. 103, li. 22 p. 104, li. 11) testified that sculpting steps were necessary to produce Snyder's plastic bank and that a trained artist and sculptor had to have spent considerable time in designing and sculpting Snyder's bank*.

Because of the several design and sculpting stages through which Snyder's bank passed between the initial cast metal Uncle Sam bank and the final plastic version, because it was an artist or sculptor who performed the various stages in the creative process and his individual artistic judgments went into his contribution and, most important, because a new work was being created, numerous changes in the shape and appearance of the plastic Uncle Sam bank, as compared with the previous metal bank, necessarily resulted. (A description of those differences may be found in Appendix G and a brief summary may be found in the Dissenting Opinion in the Court of Appeals (Appendix A) at p. 15a.)

This action proceeded through the following stages. Following publication of his copyrighted work, Snyder registered his version of the Uncle Sam bank by deposit with the Register of Copyrights. In early February, 1975,

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* Petitioner's Expert's Testimony, the Appendix in the Court of Appeals, p. 104, li. 3-11:

> "Q. Would you say that it took him hours of work in front of the original to produce the copy? What would you estimate as to how long it would take you?
>
> A. It depends on the artist.
>
> Q. How long would it take you to do that?
>
> A. About a day and a half, two days work.
>
> Q. How would you rate that—would that be an easier piece than you worked on or a more difficult piece?
>
> A. I would put it in between medium and difficult."

Snyder initiated administrative proceedings to record the Uncle Sam bank copyright registration with the United States Customs Service to bar importation of infringing plastic Uncle Sam banks in accordance with the provisions of the Copyright Act, Secs. 106, 108, 109, 61 Stat. 652, 17 U.S.C., Sec. 106, 108, 109 (1947). An Order precluding such importations was promulgated by the Customs Service in April, 1975. This action was initiated in the United States District Court by Respondent Batlin in an effort to obtain a Declaratory Judgment of the invalidity and unenforceability of Petitioner Snyder's copyright.

On May 2, 1975 the U.S. District Court for the Southern District of New York issued a Temporary Restraining Order to restrain the Customs Service and Snyder from enforcing the importation exclusion Order, pending determination of Batlin's Motion for Preliminary Injunction. After a hearing on May 6, 1975, the District Court granted a Preliminary Injunction which mandated that Petitioners Snyder and Etna Products Co., Inc. be enjoined, pendente lite, "from asserting . . . any alleged rights in . . ." the copyright here in issue, and affirmatively compelled them to cancel "the recordation . . . [of the copyright registration] with the United States Customs Service" (Appendix D).

There next followed a Stay of the Injunction issued by the Court of Appeals for the Second Circuit (Appendix E), and a later dissolution of that Stay by the same Court (Appendix F).

On October 24, 1975, the Court of Appeals for the Second Circuit, by a Majority Decision, found that the Snyder Uncle Sam bank had at least the minimal originality required for a copyrightable work (Appendix B).

Batlin then moved the Second Circuit Court of Appeals for a Rehearing *En Banc*. The Court granted the rehear-

ing. In another Majority Decision, the Court of Appeals reversed its own previous decision and affirmed the decision of the District Court and held Snyder's work to be uncopyrightable (Appendix A). The Court found that Snyder's bank lacked "originality", and in doing this, the Court asserted a new test of copyrightability: "A considerably *higher* degree of skill is required, true artistic skill to make the reproduction copyrightable."

REASONS FOR GRANTING OF THE WRIT OF CERTIORARI

I. Summary of Reasons.

It is a basic tenet of copyright law that taste forms no part of copyrightability and that a work that embodies any artistic contribution by an author has that degree of originality required for copyright. *Burrows-Giles Litho. Co.* v. *Sarony,* 111 U.S. 53, 58 (1884). However, the Second Circuit Court of Appeals has ignored the innumerable precedents to the foregoing effect and has imposed a requirement of "A considerably higher degree of skill . . . true artistic skill" as being required for a work to be copyrightable (Appendix A, p. 10a). This is a dramatic change in the copyright law, for the first time imposing a requirement that the Copyright Office and judges and juries who are determining copyrightability make a subjective determination of the level of the author's skill and artistic input. The Supreme Court, per Justice Holmes, warned long ago that judges should not, and the copyright law says they must not, engage in such artistic assessments. *Bleistein* v. *Donaldson Litho. Co.,* 188 U.S. 239, 251 (1903).

A very large proportion of reported copyright precedents are Second Circuit Court of Appeals Opinions,

whereby decisions of that Circuit have guided and shaped U.S. copyright law. Also, the split decision by the Second Circuit Court of Appeals in the present case, having been *en banc,* will receive even greater weight for *stare decisis* purposes. This Appeal has already been headlined in a number of legal publications directed to the general lawyer and the copyright specialist. It is a highly significant case in its field and warrants consideration in the Supreme Court. The Supreme Court should correct the Court of Appeals' erroneous statement of copyright law or else every artist's work on which copyright is claimed will have to be judged on artistic merit.

The developments in this case show that clarification of the copyrightability question is warranted here. Following the initial decision of the District Court, there have been four decisions of the Court of Appeals and every one of these has been a reversal of the previous decision, whereby there have been four reversals. Surely, such doubt as to the wisdom of the Court of Appeals' decision must remain as to warrant this Court granting Certiorari.

II. The *en banc* Decision of the Court of Appeals, reversing the initial Court of Appeals Decision, conflicts with a fundamental tenet of Copyright Law as laid down by Decisions of the Supreme Court.

Basic in our copyright system is that matters of "taste" or degrees of "artistry" form no part of copyrightable originality. That principle has its foundation in the Copyright Clause of the Constitution, Article I, Section 8, Clause 8, as interpreted in decisions of the Supreme Court and the other Federal Courts. The Decision by the

Second Circuit Court of Appeals will, if permitted to stand, dramatically alter that fundamental principle of our copyright system.

The Court of Appeals Opinion states:

> "Nor can the requirement of originality be satisfied simply by the demonstration of 'physical skill' or 'special training' which, to be sure, Judge Metzner found was required for the production of the plastic molds that furnished the basis for appellants' plastic bank. A considerably *higher* degree of skill is required, true artistic skill, to make the reproduction copyrightable." (Appendix A, p. 10a)

Query—What is "true artistic skill"? And by whose standards? In an Opinion of this Court, per Justice Holmes:

> "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not be to treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights. See *Henderson* v. *Tompkins*, 60 Fed. Rep. 758, 765. We are of the opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law."
>
> *Bleistein* v. *Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903)

There has never been a standard of "true artistic skill" to be found anywhere in our copyright laws, that is, not until the Opinion of the Court below. The insertion of such a standard would subject all copyrights to the arbitrary taste of those Judges before whom an issue of copyright validity was pending. It would effectively abolish the present objective registration* system in favor of a highly subjective evaluation system which was not contemplated in the Copyright Act**. The Court of Appeals Decision, if permitted to stand, will accomplish precisely what the Supreme Court cautioned against in *Bleistein* v. *Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

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* The Copyright Act, Sections 11, 13, 209, 61 Stat. 652, 17 U.S.C., Sections 11, 13, 209 (1947).

** Because the Copyright Office registers copyrights and does not examine their originality, please contemplate the following fictitious judicial colloquy, necessitated by the Decision below:

Court of Appeals Judge A: Doesn't this plastic Uncle Sam show a high degree of artistic skill?

Judge B: No, maybe if there were two more stars on his hat.

Judge C: At least an additional character, like a dog, or a totally new posture for the man is the minimum change needed for me to find true artistic skill.

Judge A: I think there is enough skill.

Decision: 2-1 against copyrightability.

The Court below requires that copyrightability hinge upon satisfying that Court's criterion of a sufficiently high degree of skill, i.e. true artistic skill. It also insists upon "an original contribution" having "at least some substantial variation", even in a reproduction, which is, by definition, a copy of a work in the public domain.

The Court below (at Appendix A, p. 12a) has misinterpreted *Mazer* v. *Stein,* 347 U.S. 201, 214 (1954), wherein the Supreme Court stated that reproductions, to be copyrightable, "must be original, that is, the author's tangible expression of his ideas". The Court below has expanded that into a requirement for originality in the sense that the production itself constitute a "substantial variation" or departure from the underlying work. But, this is essentially a requirement for novelty. "Originality" in copyrights is tied to the concept of authorship* and not to the nature or quality or novelty of the work itself. Unfortunately, confusion often arises because of the entirely different meaning "originality" has in our patent laws and the tendency to lump copyrights and patents into the same ball and call it "intellectual property law."

At the outset, it will be appreciated that copyrights do not convey a monopoly in the same sense as patents. A copyright cannot be used to preclude others from manufacturing or marketing similar products. Indeed, so long as a given product or object can trace its origin to a different "author" or creator, the copyright holder has no say in the marketplace whatever. Thus, there is simply no need for the relatively stringent requirements for originality in terms of the product or work itself which we refer to in the patent laws as novelty and unobviousness**.

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* See the next section hereof.

** The Patent Act, Sections 102, 103, 66 Stat. 797, 35 U.S.C., Sections 102, 103 (1952).

The Opinion of the Court below reveals its dissatisfaction with the plastic Uncle Sam bank because it is not novel in view of the antique metal bank. Therefore, the Court below concluded the plastic bank is not "original."

Moreover, with all due respect to the assessment by the Second Circuit Court of Appeals, the artistic talent of Snyder's Hong Kong designer is irrelevant. It is sufficient that he exercised his own personal skill, within his capabilities, to achieve that which represents his personal expression of the antique metal Uncle Sam bank. His reproduction reflects his original work, i.e. in the sense that he is its "author" or creator or parent. As a reproduction under the copyright statutes it need not satisfy an arbitor's palate for "true artistic skill" nor need it possess "at least some substantial variation."

The Senate has passed a general revision of the Copyright Law, known as the Design Protection Act of 1975, S. 22, 94th Cong., 2nd Sess. (1976). The House of Representatives is considering the enacted Senate Bill as S. 22 in the House of Representatives, 94th Cong., 2nd Sess. (1976). Although certain changes are enacted, the Bill also serves to codify existing case law. It is of interest to note that that Bill never defines or redefines originality, for that term has for so long meant copyright authorship. This is a reflection of the current state of the law, as derived from over a century of case law. Nowhere does the Bill require the copyrighted work to constitute a novel idea or a discovery or to have high artistic merit. Thus, a decision by this Court in case will not be changed by or affected by statutory changes.

It is essential to the future of our copyright system for the Supreme Court to decide by what standard we shall measure copyrightability—that of the Second Circuit now imposing a subjective test of "true artistic skill" coupled

with a revised standard for originality cloaked in patent law type novelty requirements (substantial variation), or that of a virtually endless line of precedents*, requiring simply that the reproduced object reflect its author's personal expression or handicraft and, thus, be original with him, even though it may represent but "a very modest grade of art." *Bleistein* v. *Donaldson Lithographing Co.*, 188 U.S. 239 (1911). See the Dissenting Opinion in the Court of Appeals in the present case (Appendix A), particularly at p. 16a.

III. The Decision of the Second Circuit Court of Appeals is contrary to the United States Constitution, to prior Decisions of the Second Circuit Court of Appeals and to prior Decisions of other Circuits.

The copyright in issue in this case was registered pursuant to the Copyright Act, Section 5, 61 Stat. 652, 17 U.S.C., Section 5 (1947). Congress enacted that Statute pursuant to the purpose set forth in Article I, Section 8 of the Constitution:

> "To Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Thus, as noted by the Court in *Alfred Bell & Co.* v. *Catalda Fine Arts,* 191 F.2d 99, 100 (2nd Cir. 1951) ". . . the very language of the Constitution differentiates (a) 'authors' and their 'writings' from (b) 'inventors' and their 'discoveries'." The Court in *Alfred Bell & Co.* v.

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* See the next section hereof.

Catalda Fine Arts quoted with approval the following statement from *Henderson* v. *Tompkins,* 60 Fed. 758, 764 (D. Mass. 1894):

> "There is a very broad distinction between what is implied in the word 'author', found in the constitution, and the word 'inventor.' The latter carries an implication which excludes the results of only ordinary skill, while nothing of this is necessarily involved in the former."

The Court in *Alfred Bell & Co.,* supra, further distinguished between the limits of protection accorded a copyright owner as opposed to the protection granted a patent owner stating, 191 F.2d, at 103:

> "Correlative with the greater immunity of a patentee is the doctrine of anticipation which does not apply to copyrights: The alleged inventor is chargeable with full knowledge of all the prior art, although in fact he may be utterly ignorant of it. The 'author' is entitled to a copyright if he independently contrived a work *completely identical with what went before;* similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his." [Emphasis added]

The concept of originality within the context of the Copyright Laws stems from and is equivalent to "authorship" unlike the Patent Laws where originality is related to "inventorship". *Alfred Bell & Co.* v. *Catalda Fine Arts,* supra.

In *Baker* v. *Selden,* 101 U.S. 99 (1879), for example, this Court stated at p. 102:

> "The novelty of the art or things described or explained has nothing to do with the validity of the copyright."

In *Imperial Homes Corporation* v. *Lamont,* 458 F.2d 895 (5 Cir. 1972), the Court dealt with architectural drawings for a residence, which drawings were reproduced from a copyrighted set of architectural drawings in a builder's advertising brochure. In upholding the enforceability of the copyrighted drawings, the Court said:

> "In *Burrow-Giles Lithographing Co.* v. *Sarony,* 111 U.S. 53, 58, 4 S.Ct. 279, 28 L.Ed. 348 (1884) 'an author' was defined as 'he to whom anything owes its origin; originator, maker; one who completes a work of science or literature.' Hence, the architect who originates a set of blueprints for a dwelling is as much an author for copyright purposes as the writer who creates an original novel or the dramatist who pens a new play. This authorship concept is no more than one facet of the essence of that which merits copyright protection—originality. However, while such originality is the test for copyrightability, it does not extend so far as to require that novelty or invention, which is the sine qua non for patent protection be present."

The fact that the second copy is virtually identical to the first copy is irrelevant as long as it expresses the personal reaction of the second author to the original:

> "The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and *a very modest grade of art* has in it something irreducible which is one man's alone. That something he may copyright unless there is a

> restriction in the words of the act." *Bleistein* v. *Donaldson Lithographing Co.,* 188 U.S. 239, 250 (1903) [Emphasis supplied]

In *Chautauqua School* v. *National School,* 238 Fed. 151 (2 Cir. 1916), at page 151:

> "Works alike may be original. It is not essential that any production, to be original or new within the meaning of the law of copyright, shall be different from another. Whether the composition for which copyright is claimed is the same as or different from, or whether it is like or unlike, an existing one, are matters of which the law takes no cognizance, except to determine whether the production is the result of independent labor or of copying. Two or more authors may write on the same subject, treat it similarly, and use the same common materials in like manner or for one purpose."

The Courts have always found sufficient basis for copyrightability in virtually any work created by an author's own skill, labor and judgment. See *Goldstein* v. *California,* 412 U.S. 546, 561 (1973). *Dorsey* v. *Old Surety Life Ins. Co.,* 98 F.2d 872, 873 (10 Cir. 1938).

Statuettes of elves (which are like plastic Uncle Sam banks) were held to be copyrightable by the Second Circuit Court of Appeals in *Puddu* v. *Buonamici Statuary, Inc.,* 450 F.2d 401 (2 Cir. 1971). The Court, in reversing the District Judge, observed:

> "Judge Tyler considered that the copyrighted statuettes were not sufficiently different from a 1963 uncopyrighted line as to possess the originality required for a copyright. . . .

> "However, originality has been considered to mean 'only that the work owes its origin to the author, i.e. is independently created and not copied from other works.' [Citation deleted] Plaintiff's employee, Metcalf testified without contradiction that *he had sculpted all the copyrighted statuettes* 'from scratch'. While there is a strong family resemblance between the copyrighted and the uncopyrighted models, the *differences suffice* to satisfy the *modest requirement of originality* laid down by the Supreme Court in *Bleistein* v. *Donaldson Lith. Co.*, 188 U.S. 239 (1903) and by this Court in *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.*, 191 F.2d 99 (2 Cir. 1951) . . . [450 F.2d at 402; Emphasis supplied]

Originality requires no more than the input of the author's personal effort, skill and judgment.

In *Alva Studios, Inc.* v. *Winninger,* 177 F. Supp. 265 (S.D.N.Y. 1959), the famous Rodin sculpture "Hand of God" was reproduced precisely by the copyright proprietor on an approximate one-half scale. The names, dates, size differences and other factual features of the present case could be directly substituted for those in *Alva Studios*. To quote the *Alva* Court at 177 F. Supp., p. 265:

> "It is hornbook that a new and original plan or combination of existing materials in the public domain is sufficiently original to come within the copyright protection [Citation]. However, to be entitled to copyright, the work must be original in the sense that the author has created it by his own skill, labor and judgment without directly copying or evasively imitating the work of another [Citation].

That "original" in connection with copyrights relates to the source and not to the quality or novelty of the work is also shown in an English commentary on copyrights*:

> "The meaning of the word 'original' in the Act of 1911 was discussed in a judgment . . . which has frequently been cited with approval in subsequent cases . . .
>
> "The word 'original' does not in this connection mean that the work must be the expression of original or inventive thought. Copyright Acts are not concerned with the originality of ideas, but with the expression of thought in print or writing. The originality which is required relates to the expression of the thought. But the Act does not require that the expression must be in an original or novel form, but that the work must not be copied from another work—that it should originate from the author.
>
> ". . . and it is fairly clear, in the realm of artistic works, that any change of medium will entitle a reproduction of an existing artistic work to independent protection."

The error in the thinking of the Court below is seen from *Mazer* v. *Stein,* 347 U.S. 201 (1954), wherein the Supreme Court cited, with approval, *Fred Fisher, Inc.* v. *Dillingham,* 298 Fed. 145, 151 (S.D.N.Y. 1929). In *Fisher,* two men, each of whom made identical maps of the same territory, were permitted to copyright their particular versions simply because each map was "original" to its particular author although otherwise indistinguishable.

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* Copinger and Skone James, *Copyright* (Sweet & Maxwell, London, 1965), p. 49, Sec. 119.

Any individual is free to make his own copy or reproduction. So long as he is the creator of that work, in the sense that it reflects his own personal expression of an object or idea, then it is his original work. As stated in *Bleistein* v. *Donaldson Lithographing Co.,* 188 U.S. 239 (1903): "Others are free to copy the original. They are not free to copy the copy."

Here, in the Uncle Sam bank case, designers made sketches and from those sketches a first clay model was sculpted, and then a prototype was sculpted and from that sculpted prototype a final mold was made for production purposes. Others were and are free to go through the same or any other process whereby they might reproduce the antique metal Uncle Sam bank. But they are not free to copy Snyder's copy.

That the original from which the copyrighted work was taken is in the public domain does not defeat its originality or copyrightability.

In *Axelbank* v. *Rony,* 277 F.2d 314 (9 Cir. 1960), where documentary films which were in the public domain were reproduced in a different sequence together with a running commentary, the Court said:

> "Of course, just because the source of the material is in the public domain does not void a copyright, but rather the protection is limited to the new and original contribution of the author." (429 F.2d at p. 317)

In *Blazon, Inc.* v. *Deluxe Game Corp.,* 268 F. Supp. 416, 421, 422 (S.D.N.Y. 1965), the Court stated:

> "The fact that plaintiff took a matter admittedly in the public domain, (i.e. a horse) does not in and of itself preclude a finding of originality, since

> plaintiff may have added unique features to the horse, enlarged it and made it sufficiently dissimilar from defendant's horse as to render it copyrightable to plaintiff."

In *Alva Studios, Inc.* v. *Winninger,* 177 F. Supp. 265 (S.D.N.Y. 1959), the Court held that a reproduction of Rodin's "Hand of God" in a smaller size was copyrightable. Although the original was well known and in the public domain, the Court observed:

> "one work does not violate the copyright in another simply because there is similarity between the two, if the similarity between the two results from the fact that both deal with the same subject or have the same source."

Once more, the Court reflected the fact that the true criterion for originality was whether the work reflected the author's independent efforts and skill. How close his likeness bore to the original was simply not the consideration.

In *Doran* v. *Sunset House Dist. Corp.,* 197 F. Supp. 940, 944 (S.D. Cal. 1961); affd., 304 F.2d 251 (9 Cir. 1962), a copyright on a Santa Claus figure was held valid. In *Doran,* for example the Court recognized that the copyrighted work incorporated the familiar public domain elements of the Santa Claus figure finding, nevertheless, that:

> "Here, plaintiffs *first envisioned* and then *created by their own skill, labor and judgment,* a Santa Claus in the form of a three-dimensional figure made of plastic. It is true, of course, that *plaintiffs' Santa has all of the traditional features which go to make up Santa Claus,* viz., the red suit and

> cap with white fur trim, the white hair and beard, the black belt and boots, the ruddy face and fat form. These features are part and parcel of the 'idea' of Santa Claus and hence are not copyrightable. However, the *originality here lies in the form* —three-dimentional—*and the medium*—plastic— which plaintiffs have used to express the idea of Santa Claus".

Further authorities noting the measure by which originality is determined are cited in Appendix H.

IV. The Court below performed its own incorrect test of originality and came to the wrong conclusion.

In its Opinion in the present case, the Court below discusses *Millworth Converting Corp.* v. *Slifka,* 276 F.2d 443 (2nd Cir. 1960) and notes that the fabric designed in *Millworth* required one month of work. The Court downgrades the skill of Snyder's work by commenting at Appendix A, p. 10a: "Here on the basis of appellant's own expert testimony it took the Unitoy representative 'about a day and a half, two days work' 'to produce the plastic mold sculpture from the metal Uncle Sam bank." Nowhere in the copyright law is there a requirement for the expenditure of a minimum amount of time to qualify for copyright protection.

The Court below also discusses *Alva Studios Inc.* v. *Winninger,* 177 F. Supp. 265 (S.D.N.Y. 1959) in the Opinion below, Appendix A, at p. 11a:

> "where the Court [in Alva] held that 'great skill and originality [were required] to produce a scale reduction of a great work with exactitude . . . the original sculpture was 'one of the most intricate pieces of sculpture ever created' with '[i]nnumerable planes, lines and geometric patterns . . . interdependent in [a] multidimensional work'. Originality was found by the District Court to consist primarily in the fact that 'it takes "an extremely skilled sculptor" many hours working directly in front of the original' to effectuate a scale reduction . . . the *complexity* and *exactitude there involved distinguishes* that case amply from the one at bar". [Emphasis added]

The Court below admitted there was artistic skill and effort involved in producing Snyder's plastic bank, but the Court found the quantity of such skill insufficient. The originality of Snyder's work was not recognized. At Appendix A, p. 11a, the Court below said:

> "If there be a point in the copyright law pertaining to reproductions at which sheer artistic skill and effort can act as a substitute for the requirement of substantial variation, it was not reached here."

A simple comparison of the two statues involved here, the metal and plastic banks, show that Petitioner Snyder's work was not a mere slavish imitation, but a new work created with great care for detail and considerable artistic skill over a time period which, for many works of art, is quite substantial.

The Court of Appeals had no basis for measuring originality on the false standards of its personal view of what constitutes "artistic skill" or how much time should be devoted to a work or whether that work constitutes a "substantial variation".

V. The present case has far-reaching significance in the copyright field.

As even a casual perusal of reported cases on copyrights found in Modern Federal Practice Digest under the topic Copyrights or in the United States Patents Quarterly Index under the heading Copyrights show, a disproportionately large proportion of reported copyright precedents are Opinions of the Second Circuit Court of Appeals and the District Courts in the Second Circuit. Necessarily, the decisions of that Circuit in the copyright field carry great weight. The unfortunately incorrect decision in the present case will, unless corrected by this Court, also have great weight as a precedent. In addition, the decision for which review is now being sought was rendered *en banc* which gives that decision even greater impact, despite the fact that the decision was by a divided court and a cogent dissent was written.

The Bureau of National Affairs, Inc., the well known publisher of newsletters in various branches of law, publishes the weekly "BNA's Patent, Trademark and Copyright Journal" to which, it is believed, numerous practitioners in the copyright field subscribe. The present case has been digested in this Journal. As the case has moved through its various stages, it has been discussed until the report of the split decision of the Second Circuit, sitting *en banc,* was headlined as the premier highlight in the issue of April 29, 1976 of that publication.*

In addition, for all practitioners in the New York City area, there is a daily publication, "New York Law Journal", which each day headlines an opinion, usually from

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* In Appendix I appear copies of the pertinent pages of the BNA Journal in which the case is mentioned.

a court in the New York area, which is felt to have particular significance. In the issue of November 13, 1975, the opinion of the three-judge panel in this case was singled out for such treatment by the New York Law Journal (Appendix J).

The present case is an important one. The erroneous decision and misstatement of copyright law by the Court below should be reviewed and corrected by this Court.

VI. The see-saw history of this case.

Following the original District Court decision in this case, the Court of Appeals for the Second Circuit has reviewed and rendered some decision or taken some action in connection with this case on four occasions. On every such occasion, the Court either expressly reversed or made a decision contrary to the prior decision. Following the District Court Order (Appendix D) enjoining enforcement of the copyright through the Customs Service, the Court of Appeals stayed enforcement of the Order of the District Court (Appendix E). Following this, the Court of Appeals reversed itself and dissolved the stay (Appendix F). Following this, the Court of Appeals made a contrary decision, again ordering that the Injunction against enforcement of the copyright be lifted (Appendix B). Following this, upon rehearing, the Court of Appeals again reversed itself and affirmed the grant of the Injunction by the District Court (Appendix A). In the two reported decisions of the Court of Appeals (Appendices A and B), the Panel was split, with strong majority and dissenting opinions being written both times.

With so many reversals, and no definitive unanimous decision, coupled with the strong dissent, the Court's decision resulting from the hearing *en banc* carries the

seeds of its own subsequent reversal, overruling or being distinguished by a decision in the same or another Circuit if the same issue is raised again. There is need for a definitive decision on this important point of copyright law and there is need for correction of the erroneous decision of the Court of Appeals. This Court should issue the requested Writ of Certiorari.

CONCLUSION

For the reasons stated, it is respectfully requested that this Petition for a Writ of Certiorari should be granted to review the Judgment and Opinion below of the United States Court of Appeals for the Second Circuit in this matter.

Respectfully submitted,

ROBERT C. FABER,
Attorney for Petitioner.

OSTROLENK, FABER, GERB & SOFFEN
260 Madison Avenue
New York, New York 10016
(212) 685-8470

APPENDIX A

Opinion of the United States Court of Appeals for the Second Circuit *(En Banc)* (April 12, 1976)

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 1249—September Term, 1975.

(Submitted January 19, 1976 Decided April 12, 1976.)

EN BANC

Docket No. 75-7308

L. BATLIN & SON, INC.,

Appellee,

v.

JEFFREY SNYDER d/b/a J.S.N.Y. and
ETNA PRODUCTS CO., INC.,

Appellants.

Before:

KAUFMAN, *Chief Judge,* and FEINBERG, MANSFIELD, MULLIGAN, OAKES, TIMBERS, GURFEIN, VAN GRAAFEILAND, and MESKILL, *Circuit Judges.*

Appeal from an injunction entered by the United States District Court for the Southern District of New York, Charles M. Metzner, *Judge,* restraining appellants from enforcing a copyright and interfering with the appellee's importation of an allegedly infringing mechanical toy bank. The district court found that there was a clear showing of probability of success on the merits because appellants' toy bank was only, with purely trivial variations, a copy of an antique bank long in the public domain and therefore in all probability not copyrightable. 394 F. Supp. 1389 (S.D.

N.Y. 1975). A divided panel of this court reversed. On rehearing en banc the court of appeals affirmed the grant of a preliminary injunction.

Judgment affirmed.

ROBERT C. FABER, STANLEY H. LIEBERSTEIN, New York, N.Y. (Ostrolenk, Faber, Gerb & Soffen, New York, N.Y.), *for Appellants.*

MARK H. SPARROW, New York, N.Y. (Jacobs & Jacobs, P.C., New York, N.Y., Albert L. Jacobs, Jr., of counsel), *for Appellee.*

JAMES E. SIEGEL, MYRON GREENSPAN, New York, N.Y. (Lackenbach, Lilling & Siegel, New York, N.Y.), for E. Mishan & Sons, Inc., *Amicus Curiae.*

OAKES, *Circuit Judge:*

Appellants Jeffrey Snyder and Etna Products Co., Inc., his licensee, appeal from a preliminary injunction granted L. Batlin & Son, Inc. (Batlin), compelling appellants to cancel a recordation of a copyright with the United States Customs Service and restraining them from enforcing that copyright. The district court held, 394 F. Supp. 1389 (S.D. N.Y. 1975), as it had previously in *Etna Products Co.* v. *E. Mishan & Sons,* 75 Civ. 428 (S.D.N.Y. Feb. 13, 1975), that there was "little probability" that appellants' copyright "will be found valid in the trial on the merits" on the basis that any variations between appellants' copyrighted plastic bank and a cast iron bank in the public domain were merely "trivial," and hence appellants' bank insufficiently "original" to support a copyright. 394 F. Supp. at 1390, *citing Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.,* 191 F.2d 99 (2d Cir. 1951). We agree with the

district court and therefore affirm the judgment granting the preliminary injunction.

Uncle Sam mechanical banks have been on the American scene at least since June 8, 1886, when Design Patent No. 16,728, issued on a toy savings bank of its type. The basic delightful design has long since been in the public domain. The banks are well documented in collectors' books and known to the average person interested in Americana. A description of the bank is that Uncle Sam, dressed in his usual stove pipe hat, blue full dress coat, starred vest and red and white striped trousers, and leaning on his umbrella, stands on a four- or five-inch wide base, on which sits his carpetbag. A coin may be placed in Uncle Sam's extended hand. When a lever is pressed, the arm lowers, and the coin falls into the bag, while Uncle Sam's whiskers move up and down. The base has an embossed American eagle on it with the words "Uncle Sam" on streamers above it, as well as the word "Bank" on each side. Such a bank is listed in a number of collectors books, the most recent of which may be F. H. Griffith, Mechanical Banks (1972 ed.) where it was listed as No. 280, and is said to be not particularly rare.

Appellant Jeffrey Snyder doing business as "J.S.N.Y." obtained a registration of copyright on a plastic "Uncle Sam bank" in Class G ("Works of Art") as "sculpture" on January 23, 1975. According to Snyder's affidavit, in January, 1974, he had seen a cast metal antique Uncle Sam bank with an overall height of the figure and base of 11 inches.[1] In April, 1974, he flew to Hong Kong to arrange for the design and eventual manufacture of replicas of the bank as Bicentennial items, taking the cast metal Uncle Sam

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1 No cast iron *antique* bank was introduced in evidence below. A cast metal *replica* bank was, and the court below, the parties, the witnesses, and this court have treated the case as if the appellants' plastic bank were to be compared to the cast metal replica.

bank with him. His Hong Kong buying agent selected a firm, "Unitoy," to make the plastic "prototype" because of its price and the quality of its work. Snyder wanted his bank to be made of plastic and to be shorter than the cast metal sample "in order to fit into the required price range and quality and quantity of material to be used." The figure of Uncle Sam was thus shortened from 11 to nine inches, and the base shortened and narrowed. It was also decided, Snyder averred, to change the shape of the carpetbag and to include the umbrella in a one-piece mold for the Uncle Sam figure, "so as not to have a problem with a loose umbrella or a separate molding process." The Unitoy representative made his sketches while looking at the cast metal bank. After a "clay model" was made, a plastic "prototype" was approved by Snyder and his order placed in May, 1974. The plastic bank carried the legend "© Copyright J.S.N.Y." and was assertedly first "published" on October 15, 1974, before being filed with the Register of Copyrights in January, 1975.

Appellee Batlin is also in the novelty business and as early as August 9, 1974, ordered 30 cartons of cast iron Uncle Sam mechanical banks from Taiwan where its president had seen the bank made. When he became aware of the existence of a plastic bank, which he considered "an almost identical copy" of the cast iron bank, Batlin's trading company in Hong Kong procured a manufacturer and the president of Batlin ordered plastic copies also. Beginning in April, 1975, Batlin was notified by the United States Customs Service that the plastic banks it was receiving were covered by appellants' copyright. In addition the Customs Service was also refusing entry to cast iron banks previously ordered, according to the Batlin affidavit. Thus Batlin instituted suit for a judgment declaring appellants' copyright void and for damages for unfair competition and

restraint of trade. The sole question on this appeal is whether Judge Metzner abused his discretion in granting Batlin a preliminary injunction. We find that he did not.

This court has examined both the appellants' plastic Uncle Sam bank made under Snyder's copyright and the uncopyrighted model cast iron mechanical bank which is itself a reproduction of the original public domain Uncle Sam bank. Appellant Snyder claims differences not only of size but also in a number of other very minute details: the carpetbag shape of the plastic bank is smooth, the iron bank rough; the metal bank bag is fatter at its base; the eagle on the front of the platform in the metal bank is holding arrows in his talons while in the plastic bank he clutches leaves, this change concededly having been made, however, because "the arrows did not reproduce well in plastic on a smaller size." The shape of Uncle Sam's face is supposedly different, as is the shape and texture of the hats, according to the Snyder affidavit. In the metal version the umbrella is hanging loose while in the plastic item it is included in the single mold. The texture of the clothing, the hairline, shape of the bow ties and of the shirt collar and left arm as well as the flag carrying the name on the base of the statue are all claimed to be different, along with the shape and texture of the eagles on the side. Many of these differences are not perceptible to the casual observer. Appellants make no claim for any difference based on the plastic mold lines in the Uncle Sam figure which are perceptible.

Our examination of the banks results in the same conclusion as that of Judge Metzner in *Etna Products*, the earlier case enjoining Snyder's copyright, that the Snyder bank is "extremely similar to the cast iron bank, save in size and material" with the only other differences, such as the shape of the satchel and the leaves in the eagle's talons being "by all appearances, minor." Similarities include,

more importantly, the appearance and number of stripes on the trousers, buttons on the coat, and stars on the vest and hat, the attire and pose of Uncle Sam, the decor on his base and bag, the overall color scheme, the method of carpetbag opening, to name but a few. After seeing the banks and hearing conflicting testimony from opposing expert witnesses as to the substantiality or triviality of the variations and as to the skill necessary to make the plastic model, the court below stated:

> I am making a finding of fact that as far as I'm concerned, it is practically an exact copy and whatever you point to in this [sic] differences are so infinitesimal they make no difference. All you have proved here by the testimony today is that if you give a man a seven-inch model and you say I want this to come out in a five-inch model, and he copies it, the fact that he has to have some artistic ability to make a model by reducing the seven to the five adds something to it. That is the only issue in this case.
>
> Mr. Faber: No, sir.
>
> The Court: That is the only issue. I have given you my finding of fact.

As Judge Metzner went on to say in his opinion, the appellants' plastic version "reproduces" the cast iron bank "except that it proportionately reduces the height from approximately 11 inches to approximately nine inches with trivial variations." 394 F. Supp. at 1390. The court noted that appellants "went to great pains on the hearing to prove that there were substantial differences between the iron and the plastic articles," *id.* at 1391, and found that there had been no "level of input" such as in *Alva Studios, Inc.* v. *Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959) ("great skill and originality" called for in producing an exact scale reduction of Rodin's famous "Hand of God," to

museum specifications). The substance of appellee's expert's testimony on which the district judge evidently relied was that the variations found in appellants' plastic bank were merely "trivial" and that it was a reproduction of the metal bank made as simply as possible for the purposes of manufacture. In other words, there were no elements of difference that amounted to significant alteration or that had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium.

What the leading authority has called "the one pervading element prerequisite to copyright protection regardless of the form of the work" is the requirement of originality —that the work be the original product of the claimant. 1 M. Nimmer, The Law of Copyright § 10, at 32 (1975). This derives from the fact that, constitutionally, copyright protection may be claimed only by "authors." U.S. Const., art. I, § 8; *Burrow-Giles Lithographic Co.* v. *Sarony*, 111 U.S. 53, 58 (1884). Thus, "[o]ne who has slavishly or mechanically copied from others may not claim to be an author." 1 M. Nimmer, *supra*, § 6, at 10.2. Since the constitutional requirement must be read into the Copyright Act, 17 U.S.C. § 1 *et seq.*, the requirement of originality is also a statutory one. *Chamberlin* v. *Uris Sales Corp.*, 150 F.2d 512 (2d Cir. 1945). It has been the law of this circuit for at least 30 years that in order to obtain a copyright upon a reproduction of a work of art under 17 U.S.C. § 5(h)[2] that the work "contain some substantial, not merely trivial originality . . . ." *Chamberlin* v. *Uris Sales Corp.*, *supra*, 150 F.2d at 513.

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2 While appellant Snyder's copyright was obtained for a "Work of Art," it may be treated as one obtained for "reproductions of a work of art," *Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974), since errors in classification do not invalidate or impair copyright protection under this express language of 17 U.S.C. § 5.

Originality is, however, distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty, since the Constitution differentiates "authors" and their "writings" from "inventors" and their "discoveries." *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc., supra,* 191 F.2d at 100; *Runge* v. *Lee,* 441 F.2d 579, 581 (9th Cir.), *cert. denied,* 404 U.S. 887 (1971). Originality means that the work owes its creation to the author and this in turn means that the work must not consist of actual copying. *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc., supra,* 191 F.2d at 102-03; *Sheldon* v. *Metro-Goldwyn Pictures Corp.,* 81 F.2d 49, 54 (2d Cir. 1936), *aff'd,* 309 U.S. (1940).[3]

The test of originality is concededly one with a low threshold in that "[a]ll that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'" *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.,* 191 F.2d at 103. But as this court said many years ago, "[w]hile a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will . . . ." *Gerlach-Barklow Co.* v. *Morris & Bendien, Inc.,* 23 F.2d 159, 161 (2d Cir. 1927).

Necessarily, none of these underlying principles is different in the case of "[r]eproductions of a work of art," 17 U.S.C. § 5(h), from the case of "[w]orks of art . . .," 17 U.S.C. § 5(g). The requirement of substantial as opposed to trivial variation and the prohibition of mechanical copying, both of which are inherent in and subsumed

3 The only case that appears to be an exception to this rule is the "Hand of God" case. *Alva Studios, Inc.* v. *Winninger,* 177 F. Supp. 265 (S.D.N.Y. 1959) (exact scale artistic reproduction of highly complicated statue made with great precision was "original" as requiring "great skill and originality"). This case is discussed in the text *infra.*

by the concept of originality, apply to both statutory categories. There is implicit in that concept a "minimal element of creativity over and above the requirement of independent effort." 1 M. Nimmer, *supra,* § 10.2, at 36. While the quantum of originality that is required may be modest indeed, *Herbert Rosenthal Jewelry Corp.* v. *Grossbardt,* 436 F.2d 315, 316 (2d Cir. 1970), we are not inclined to abandon that requirement, even if in the light of the constitutional and statutory bases therefor and our precedents we could do so.

A reproduction of a work of art obviously presupposes an underlying work of art. Since *Mazer* v. *Stein,* 347 U.S. 201, 218 (1954) (statuette of Balinese dancer copyrightable despite intended use as lamp base), it has been established that mass-produced commercial objects with a minimal element of artistic craftsmanship may satisfy the statutory requirement of such a work. *See also Puddu* v. *Buonamici Statuary, Inc.,* 450 F.2d 401, 402 (2d Cir. 1971). So, too, a toy which qualifies as a work of art such as the original Uncle Sam mechanical bank may qualify as a "work of art" under Section 5(g). *See Rushton* v. *Vitale,* 218 F.2d 434, 435-36 (2d Cir. 1955); *Ideal Toy Corp.* v. *Sayco Doll Corp.,* 302 F.2d 623, 624 (2d Cir. 1962). The underlying work of art may as here be in the public domain. But even to claim the more limited protection given to a reproduction of a work of art (that to the distinctive features contributed by the reproducer), the reproduction must contain "an original contribution not present in the underlying work of art" and be "more than a mere copy." 1 M. Nimmer, *supra,* § 20.2, at 93.

According to Professor Nimmer, moreover, "the mere reproduction of a work of art in a different medium should not constitute the required originality for the reason that no one can claim to have independently evolved any particular medium." *Id.* at 94. *See Millworth Converting*

Appendix A

Corp. v. *Slifka*, 276 F.2d 443, 444-45 (2d Cir. 1960). *Cf. Gardenia Flowers, Inc.* v. *Joseph Markovitz, Inc.*, 280 F. Supp. 776, 781 (S.D.N.Y. 1968). Professor Nimmer refers to *Doran* v. *Sunset House Distributing Corp.*, 197 F. Supp. 940 (S.D. Cal. 1961), *aff'd*, 304 F.2d 251 (9th Cir. 1962), as suggesting "the ludicrous result that the first person to execute a public domain work of art in a different medium thereafter obtains a monopoly on such work in such medium, at least as to those persons aware of the first such effort." 1 M. Nimmer, *supra*, § 20.2, at 94. We do not follow the *Doran* case. We do follow the school of cases in this circuit and elsewhere supporting the proposition that to support a copyright there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium.

Nor can the requirement of originality be satisfied simply by the demonstration of "physical skill" or "special training" which, to be sure, Judge Metzner found was required for the production of the plastic molds that furnished the basis for appellants' plastic bank. A considerably *higher* degree of skill is required, true artistic skill, to make the reproduction copyrightable. Thus in *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.*, *supra*, 191 F.2d at 104-05 n.22, Judge Frank pointed out that the mezzotint engraver's art there concerned required "great labour and talent" to effectuate the "management of light and shade . . . produced by different lines and dots . . . ," means "very different from those employed by the painter or draughtsman from whom he copies . . . ." *See also Millworth Converting Corp.* v. *Slifka, supra* (fabric designer required one month of work to give three-dimensional color effect to flat surface). Here on the basis of appellants' own expert's testimony it took the Unitoy representative "[a]bout a day and a half, two days work" to produce the plastic

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mold sculpture from the metal Uncle Sam bank. If there be a point in the copyright law pertaining to reproductions at which sheer artistic skill and effort can act as a substitute for the requirement of substantial variation, it was not reached here.

Appellants rely heavily upon *Alva Studios, Inc.* v. *Winninger, supra*, the "Hand of God" case, where the court held that "great skill and originality [were required] to produce a scale reduction of a great work with exactitude." 177 F. Supp. at 267. There, the original sculpture was "one of the most intricate pieces of sculpture ever created" with "[i]nnumerable planes, lines and geometric patterns . . . interdependent in [a] multi-dimensional work." *Id.* Originality was found by the district court to consist primarily in the fact that "it takes 'an extremely skilled sculptor' many hours working directly in front of the original" to effectuate a scale reduction. *Id.* at 266. The court, indeed, found the exact replica to be so original, distinct, and creative as to constitute a work of art in itself. The complexity and exactitude there involved distinguishes that case amply from the one at bar. As appellants themselves have pointed out, there are a number of trivial differences or deviations from the original public domain cast iron bank in their plastic reproduction. Thus concededly the plastic version is not, and was scarcely meticulously produced to be, an exactly faithful reproduction. Nor is the creativity in the underlying work of art of the same order of magnitude as in the case of the "Hand of God." Rodin's sculpture is, furthermore, so unique and rare, and adequate public access to it such a problem that a significant public benefit accrues from its precise, artistic reproduction. No such benefit can be imagined to accrue here from the "knock-off" reproduction of the cast iron Uncle Sam bank. Thus appellants' plastic bank is neither in the category of exactitude required by *Alva Studios* nor in a

category of substantial originality; it falls within what has been suggested by the amicus curiae is a copyright no-man's land.

Absent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts—indeed, the constitutional demand, *Chamberlin* v. *Uris Sales Corp., supra*—could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work. Even in *Mazer* v. *Stein, supra,* which held that the statutory terms "works of art" and "reproduction of works of art" (terms which are clearly broader than the earlier term "works of the fine arts") permit copyright of quite ordinary mass-produced items, the Court expressly held that the objects to be copyrightable, "must be original, that is, the author's tangible expression of his ideas." 347 U.S. at 214. No such originality, no such expression, no such ideas here appear.

To be sure, the test of "originality" may leave a lot to be desired, although it is the only one we have, in that as one scholar has said, the originality requirement does not perform the function of excluding commonplace matters in the public domain from copyright status very effectively. *See* Comment, *Copyright Protection for Mass Produced Commercial Products: A Review of the Developments Following Mazer* v. *Stein,* 38 U. Chi. L. Rev. 807 (1971). In any event, however, the articles should be judged on their own merits, *id.* at 823, and on these merits appellants' claim must fail. Here as elsewhere in the copyright law there are lines that must be drawn even though reasonable men may differ where.

Judgment affirmed.

MESKILL, *Circuit Judge* (dissenting):

I respectfully dissent.

In the instant case the author has contributed substantially more than a merely trivial variation. "Any 'distinguishable variation' of a prior work will constitute sufficient originality to support a copyright if such variation is the product of the author's independent efforts, and is more than merely trivial." 1 Nimmer on Copyright § 10.1 at 34.2. In accord with the purposes of the copyright law to promote progress by encouraging individual effort through copyright protection, we should require only minimal variations to find copyrightability. The independent sculpting of the mold for the plastic bank and the aggregated differences in size and conformation of the figurine should satisfy this standard.

The plastic bank in question admittedly is based on a work now in the public domain. This does not render it uncopyrightable since "[i]t is hornbook that a new and original plan or combination of existing materials in the public domain is sufficiently original to come within the copyright protection. . . ." *Alva Studios, Inc.* v. *Winninger,* 177 F.Supp. 265, 267 (S.D.N.Y. 1959). The courts have repeatedly emphasized that only a modest level of originality is necessary to be eligible for a copyright. *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.,* 191 F.2d 99, 102-103 (2 Cir. 1951). *See also, Thomas Wilson & Co.* v. *Irving J. Dorfman Co.,* 433 F.2d 409, 411 (2 Cir. 1970) and *Dan Kasoff, Inc.* v. *Novelty Jewelry Co., Inc.,* 309 F.2d 745, 746 (2 Cir. 1962), where this Court required only a "faint trace of originality" to support a copyright.

Looking first to copyright cases involving sculptures, in *Puddu* v. *Buonamici Statuary, Inc.,* 450 F.2d 401, 402 (2 Cir. 1971), this Court found that where plaintiff's employee had sculpted statuettes from scratch, even though

there was a "strong family resemblance between the copyrighted and the uncopyrighted models, the differences suffice to satisfy the modest requirement of originality. . . . Originality sufficient for copyright protection exists if the 'author' has introduced any element of novelty as contrasted with the material previously known to him." Similarly, in *Blazon, Inc.* v. *DeLuxe Game Corp.*, 268 F.Supp. 416, 422 (S.D.N.Y. 1965) the court assumed a hobby horse could be copyrightable since plaintiff could have added "unique features to the horse, enlarged it and made it sufficiently dissimilar from defendant's horse as to render it copyrightable. . . ." See also *Royalty Designs, Inc.* v. *Thrifticheck Service Corp.*, 204 F.Supp. 702 (S.D.N.Y. 1962) (banks in shape of dogs); *F. W. Woolworth Co.* v. *Contemporary Arts*, 193 F.2d 162 (1 Cir. 1951) (originality in shape of dog figurine). The fabric cases likewise have found designs copyrightable with only a "very modest grade of originality." *Peter Pan Fabrics, Inc.* v. *Dan River Mills, Inc.*, 295 F.Supp. 1366, 1368 (S.D.N.Y. 1969). In the latter case, the embellishment and expansion of purchased designs before being rolled onto fabric constituted the "slight addition" sufficient to qualify as originality. Finally, there are also cases where *no* changes were required because the process of reproduction itself required great skill. See *Alva Studios, Inc.* v. *Winninger, supra,* where originality was found in a detailed scaled reproduction differing only in the treatment of the rear side of the base; see also *Millworth Converting Corp.* v. *Slifka*, 276 F.2d 443 (2 Cir. 1960) (creation of a three dimensional effect on a flat fabric required effort and skill).

Turning to the case at bar, Judge Metzner made a factual finding that the plastic bank embodied only trivial variations from the bank in the public domain. There is precedent in this Circuit to support appellate reconsideration of factual findings where the panel has the same record and

no part of the decision below turned on credibility. *Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1093 (2 Cir. 1974) (per curiam). This principle should be applied to the present situation since this Court has had the opportunity to view the exhibits. I make no claim that the process of sculpting involved here is as complex as in *Alva Studios* (scaled version of Rodin sculpture) or in *Alfred Bell* (mezzotint engravings of art classics). However, those cases depended solely on difficulty of process to establish originality, since there was no attempt to alter or improve upon the underlying work.

The most obvious differences between the two exhibits in this case are size and medium. While these factors alone may not be sufficient to render a work copyrightable, they surely may be considered along with the other variations. On the other hand, the author's reasons for making changes should be irrelevant to a determination of whether the differences are trivial. As noted in *Alfred Bell, supra,* 191 F.2d at 105, even an inadvertent variation can form the basis of a valid copyright. After the fact speculation as to whether Snyder made changes for aesthetic or functional reasons should not be the basis of decision.

The primary variations between the two banks involve height; medium; anatomical proportions of the Uncle Sam figure, including shape and expression of face; design of the clothing (hat, tie, shirt, collar, trousers); detail around the eagle figure on the platform; placement of the umbrella; and the shape and texture of the satchel. Granting Snyder a copyright protecting these variations would ensure only that no one could copy his particular version of the bank now in the public domain, i.e., protection from someone using Snyder's figurine to slavishly copy and make a mold. In *Alva Studios, supra,* 177 F. Supp, at 267, where the author produced no distinctive variations of his own in reproducing the Rodin sculpture, the court still found

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that the reproduction was copyrightable and that infringement was possible; although mere resemblance would not justify a finding of infringement where the principal elements of a design were taken from the public domain, evidence of actual copying would support such a finding.

This approach seems quite in accord with the purpose of the copyright statute—to promote progress by encouraging individual effort through copyright protection. The relatively low standard of originality required for copyrightability is derived from this purpose. The objective is to progress first and, if necessary, litigate the question of infringement later. In the meantime, the public culture benefits from progress; the issue of who is entitled to the profits should not induce rigidity and slowness in industries and fields naturally subject to great flux.

Accordingly, I would reverse the district court decision.

APPENDIX B

Opinion of the United States Court of Appeals for the Second Circuit (October 24, 1975)

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 1249—September Term, 1974.

(Argued August 11, 1975 Decided October 24, 1975.)

Docket No. 75-7308

L. BATLIN & SON, INC.,

Plaintiff-Appellee,

v.

JEFFREY SNYDER, d/b/a J.S.N.Y. and
ETNA PRODUCTS CO., INC.,

Defendants-Appellants.

Before:

OAKES, VAN GRAAFEILAND and MESKILL,
Circuit Judges.

Appeal from an injunction granted by the District Court for the Southern District of New York, Charles M. Metzner, *J.*, restraining appellant Synder from enforcing his copyright and interfering with the appellee's importation of a possibly infringing toy bank. The district court found that there was a clear showing of probability of success on the merits because the toy bank was with minor variations taken from the public domain and was not copyrightable. (Reported below at 394 F.Supp. 1389.)

Reversed.

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MARK H. SPARROW, New York, New York (Jacobs & Jacobs, P.C., New York, New York, of counsel), *for Plaintiff-Appellee.*

ROBERT C. FABER, New York, New York (Marc S. Gross, Ostrolenk, Faber, Gerb & Soffen, New York, New York, of counsel), *for Defendants-Appellants.*

MESKILL, *Circuit Judge:*

The appellants, Jeffrey Snyder and Etna Products Co., Inc. (For the sake of convenience, the appellants herein will be referred to collectively as "Snyder"), appeal from a preliminary injunction in favor of the appellee, L. Batlin & Son, Inc. ("Batlin") compelling Snyder to cancel a recordation of a copyright with the United States Customs Service, and restraining him from enforcing that copyright. The District Court for the Southern District of New York (Metzner, *J.*), based its action granting the injunction upon a finding that the object of the purported copyright was not entitled to that protection. We reverse, and vacate the preliminary injunction.

I. FACTUAL BACKGROUND

In 1886 a design patent was obtained on an eleven-inch high cast iron mechanical Uncle Sam bank. This bank ("basic bank") passed into the public domain when the patent protection expired some time prior to 1909. Act of July 8, 1870, c. 230 § 73, 16 Stat. 210, now 35 U.S.C. § 173. In the spring of 1974, Snyder procured a sculptor to model a nine-inch replica of the original bank. The smaller model was tranformed into a mold. From that mold, plastic versions of the Uncle Sam bank ("Snyder bank") were produced in Hong Kong and shipped to this country for sale by Snyder. The nine-inch plastic bank

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and the original eleven-inch metal bank are generally similar. Each consists of a representation of "Uncle Sam" attired in patriotic garb, standing on a soap box with a carpetbag at his side. Uncle Sam accepts a coin placed into his outstretched right hand, and, when the donor presses a lever, Uncle Sam deftly inserts the coin into his bag. His mouth opens and closes as if to say "thank you."

Snyder obtained a copyright on his version of the bank, claiming it to be a work of art.[1] *See, e.g., Royalty Designs, Inc.* v. *Thriftneck Service Corp.*, 204 F.Supp. 702, 703 (S.D.N.Y., 1962). Subsequently, Batlin attempted to import his own plastic version of the bank which was also produced in Hong Kong. Batlin claims that he was substantially blocked from this endeavor by the United States Customs Service, which, presumably, at Snyder's behest, refused to permit entry of this other bank, pursuant to Customs Regulations which permit the exclusion of pirated or infringing goods, 19 C.F.R. § 133. He further claims that he received a letter from Snyder threatening suit should he persist in marketing the bank. Thereupon, Batlin filed suit in district court, seeking a declaratory judgment and damages from claims of unfair competition and violation of antitrust law, and requesting relief in the form of preliminary and permanent injunctions.[2] Batlin

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1 17 U.S.C. § 5(g), set forth in Footnote 8. If the item does not fall under (g) as a work of art, the mistake in designation of the appropriate subsection of the law in the application is not fatal. If the object falls into any other category of copyrightable items, it is protected nevertheless. 17 U.S.C. § 5; *Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir., 1974), *cert. denied*, 416 U.S. 986; *Peter Pan Fabrics, Inc.* v. *Dan River Mills, Inc.*, 295 F.Supp. 1366, 1368 (S.D.N.Y.), *aff'd.* 415 F.2d 1007 (2d Cir., 1969).

2 The plaintiff also joined the United States Customs Service in its suit and its request for preliminary relief. It requested the district court to enjoin the Customs Service from enforcing the defendants' copyright and excluding entry to the plaintiff's bank. The court's action in dismissing that portion of the action is not at issue on this appeal.

alleged that it will suffer irreparable damage by virtue of loss of profits and goodwill, due to its inability to live up to its commitment to deliver orders because of the Customs Service ban on importation of its bank.

This is not the first time that the district court has had to deal with "Uncle Sam's" fate. *Etna Products and Jeffrey Snyder, d/b/a J.S.N.Y.* v. *E. Mishan & Sons,* 75 Civ. 428 (S.D.N.Y., 1975) was an earlier case launched by Snyder, wherein he sought a preliminary injunction, claiming copyright infringement and unfair competition. The district court granted relief to Snyder on the unfair competition ground only, finding that it had serious doubts as to whether the copyright could be sustained.[3] Consistently with its determination in that case, the same court had difficulty with the copyrightability of Snyder's bank in the instant case. It noted that "to support a valid copyright as a reproduction, only originality is required. *Gardenia Flowers, Inc.* v. *Joseph Markowits, Inc.,* 280 F.Supp. 776 (S.D.N.Y., 1968); Nimmer on Copyrights, § 20.3." The court went on to say ". . . [Snyder] contends that the concept of originality embraces a mere copying if it requires artistic skill to achieve the finished product. The [District] Court agrees that in this case a degree of physical artistic skill was necessary to produce the plastic article. What [Snyder overlooks] is that this artistic skill must *contribute* to the work. It must be more than a *merely trivial variation,* which is all that is present here. The need for artistic skill in the execution of the copy is not sufficient [to satisfy the need for copyrightability]." The court went on to conclude that since there was little probability that the Snyder bank would be held to be copyrightable, there was a clear showing that Batlin would

3 That case, *Etna Products and Jeffrey Snyder, d/b/a J.S.N.Y.* v. *E. Mishan & Sons,* is being held in abeyance pending the outcome of this appeal, in which E. Mishan & Sons has participated as *amicus curiae.*

probably succeed at a trial on the merits.[4] Thereupon, the district court granted Batlin's application for a preliminary injunction, restrained Snyder from enforcing his copyright and ordered him to cancel his recordation of it with the United States Customs Service pending adjudication of the issue on the merits.

Upon appeal, an order granting or denying a preliminary injunction will not lightly be disturbed, unless it contravenes some rule in equity or is the result of improvident exercises of judicial discretion. *Meccano Ltd.* v. *John Wannamaker, New York,* 253 U.S. 136, 140 (1920); *American Visuals Corp.* v. *Holland,* 219 F.2d 223, 224 (2d Cir., 1955); *Joshua Meir Co.* v. *Albany Novelty Mfg. Co.,* 236 F.2d 144, 146 (2d Cir., 1956).[5]

Works within the public domain are rendered noncopyrightable by 17 U.S.C. § 8.[6] Although the basic bank is itself excluded from copyright protection, Snyder's repro-

4 It appears that the parties have conceded the existence of irreparable harm, hence that issue is not before us. However, with respect to an injunction restraining the appellants from enforcing their copyright with the United States Customs Service, it does not appear from the record that the issue of the appellee's exhaustion of remedies with the Customs Service was raised. A determination on this issue could conclude the case.

5 *Amicus* E. Mishan & Sons' argument that the injunction should be sustained in order to preserve the *status quo* is not well taken. The injunction changed the *status quo* by preventing the appellant from enforcing the copyright. Actions temporarily enforcing a copyright, thereby barring parties from doing business, have been sustained, pending litigation. *Omega Importing Corp.* v. *Petri-Kline Camera Co.,* 451 F.2d 1190, 1197 (2d Cir., 1971), *cert. denied,* 408 U.S. 943; *American Code Co., Inc.* v. *Bensinger,* 282 F. 829, 835 (2d Cir., 1922).

6 17 U.S.C. § 8 states in pertinent part:

"§ 8. Copyright not to subsist in works in public domain, or published prior to July 1, 1909, and not already copyrighted . . .

No copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to July 1, 1909, and has not been already copyrighted in the United States . . . ."

duction of it is copyrightable if it may be regarded as an adaptation of a work of art in the public domain, 17 U.S.C. § 7.[7] It may qualify either as a work of art, 17 U.S.C. § 5(g) as claimed in Snyder's application, or as a reproduction of a work of art, 17 U.S.C. § 5(h).[8] Thus the fact that an idea is in the public domain does not render an expression of that idea uncopyrightable. *Donald* v. *Uarco Business Forms,* 478 F.2d 764, 766 (8th Cir., 1973); *M. M. Business Forms Corp.* v. *Uarco, Inc.,* 472 F.2d 1137, 1139 (6th Cir., 1973); *Millworth Converting Corp.* v. *Slifka,* 276 F.2d 443, 445 (2d Cir., 1960) (dictum). *See also: American Code Co., Inc.* v. *Bensinger,* 282 F. 829, 834 (2d Cir., 1922); *Axelbank* v. *Rony,* 277 F.2d 314, 317 (9th Cir., 1960); *Continental Casualty* v. *Beardsley,* 253 F.2d 702 (2d Cir., 1958), *cert. denied,* 358 U.S. 816; *Alfred Bell &*

7 § 7. Copyright on compilations of works in public domain or of copyrighted works; subsisting copyrights not affected . . .

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

8 That section provides, in pertinent part, as follows:

§ 5. Classification of works for registration. . . .

The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

* * * * *

(g) Works of art; models or designs for works of art.
(h) Reproductions of a work of art.

* * * * *

The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secured under this title.

Co., Ltd. v. *Catalda Fine Arts, Inc.,* 191 F.2d 99, 102 (2d Cir., 1951); *Dorsey* v. *Old Surety Life Ins. Co.,* 98 F.2d 872, 873 (10th Cir., 1938); *Grove Press, Inc.* v. *Collectors Publication, Inc.,* 264 F.Supp. 603 (C.D.Cal., 1967); *But Cf. Harold Lloyd Corp.* v. *Witwer,* 65 F.2d 1, 17, 18 (9th Cir., 1933), *cert. denied,* 296 U.S. 669. Hence, the instant appeal presents the question of determining whether this reproduction of a work in the public domain is a fit subject for protection under the copyright laws as a work of art, or as a reproduction of a work of art. The record, fortified by the district court's carefully formulated findings, is sufficiently ripe for appellate review. We must determine whether Uncle Sam can ever attain the status of art, or forever be condemned to an ignoble and unprotected commercial status. *Eg. Rushton* v. *Vitale,* 218 F.2d 434, 436 (2d Cir., 1955).

II. "Work of Art" and Copyrightability

The difficulty in fashioning a precise definition for the term "work of art" is manifest. We are faced with the task of formulating an expression sufficient to guide judicial interpretation with consistency, without imposing a new orthodoxy over esthetic sensibility. *Bleistein* v. *Donaldson Lithographing Co.,* 188 U.S. 239, 251 (1903). Webster devotes more than half a column in an attempt to define the term, the pertinent parts of which are reproduced in the margin.[9] 37 C.F.R. § 202.10, the Copyright

9 Webster's Third New International Dictionary (Unabridged) (1961) states:

. . . Systematic application of knowledge or skill in effecting a desired result . . . application of skill and taste to production according to aesthetic principles: the conscious use of skill, taste, and creative imagination in the practical definition or production of beauty . . . the product of skill and taste applied according to aesthetic principles: expression of beauty . . . ART is the most variable of these words in meaning, often interchangeable with,

Office Regulations, are no more specific in formulating a workable test.[10]

In order to properly understand the term as it should be applied, we must analyze the purpose of the copyright legislation in the light of history. *Metro-Goldwyn-Mayer D. Corp.* v. *Bijou Theatre Co.*, 59 F.2d 70, 76 (1st Cir., 1932). The law of copyrights evolved from two roots: common law and legislation. The former concerned the right of an author to initially publish works identical to his own. 2 Blackstone, Commentaries (1766) Ch. 26, § 8. *See Public Affairs Associates, Inc.* v. *Rickover*, 284 F.2d 262, 267 (2d Cir., 1960). The latter developed as a means of protecting the correctness of the copies, and not the property rights of the author. It was a type of quality-control device, later extended to protect the printer's rights. Under Henry VIII (1533), it was utilized to protect England's printers from foreign competition.[11] Later it was used for the purpose of suppressing sedition. Both, however, concerned the protection of literary works and revolved around the growth of printing.[12] R. R. Bowker, *Copyright: Its History and Its Law*, 8-41; *e.g.*, *United States* v. *Steffens*, 100 U.S. 82, 94 (1879).

It is only in the mid-nineteenth century that the copyright protection was extended to works of art and reproductions of them.[13] The continued expansion of the ambit of copyright protection is merely a transposition of the same type of protection accorded to written works to different modes of expression. *Markham* v. *A. E. Borden Co.*, 206 F.2d 199, 202 (1st Cir., 1953) (Dictum); note, Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following *Mazer* v. *Stein*, 28 U.Chi.L.Rev. 807, 808. The extension of the law did not increase the scope of the protection afforded; it merely added to the list of subjects covered. In this respect, it is critical to note that the scope of the

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often contrasting with, the others: [skill, craft, artifice] its significant weight can fall upon recondite, inventive, or creative power. It can, like SKILL, suggest proficiency or expertness . . . or, like CRAFT, or, rarely, like ARTIFICE, can point to skill, ingenuity, and inventiveness in contriving even though the act or result lacks any true creative force or quality . . . . But more frequently and in its most distinct sense ART contrasts with SKILL, ARTIFICE, and CRAFT in putting stress upon something more, in implying a personal, un-analyzable creative force that transmits and raises the art or product beyond a skill, artifice, or craft though it may involve the essential elements of all of these . . . .

10 37 C.F.R. § 202.10:

§ 202.10 Works of art (Class G).

(a) General. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings and sculpture.

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. The registrability of a work of art is not affected by the intention of the author as to the use of the work, the number of copies reproduced, or the fact that it appears on a textile material or textile product. The potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been issued.

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, which can be identified separately and are capable of existing independently as a work of art, such features will be eligible for registration.

11 This protectionist element survives, *see* 17 U.S.C. § 16.

12 Except perhaps in Roman times. *See* R. R. Bowker, *Copyright: Its History and Its Laws*, 8.

13 The Copyright Act of 1870 extended coverage to "paintings, drawings, choromos, statutes, [sic] statuary and models and designs intended to be perfected as works of the fine arts." R.S. § 4952 (Act of July 8, 1870, c. 230 § 86). *See Mazer* v. *Stein*, 347 U.S. 201, 204 (1954).

protection extended only to the particular expression of an idea and never to the idea itself. *Mazer* v. *Stein*, 347 U.S. 201, 217 (1954); *Baker* v. *Selden*, 101 U.S. 99, 102-103 (1897); *Universal Athletic Sales Co.* v. *Salkeld*, 511 F.2d 904, 906 (3d Cir., 1973); *M. M. Business Forms Corp.*, v. *Uarco, Inc., supra*, 472 F.2d 1137, 1139; *Uneeda Doll Co., Inc.* v. *P & M Doll Co., Inc.*, 353 F.2d 788, 789 (2d Cir., 1965); *Welles* v. *Columbia Broadcasting System*, 308 F.2d 810, 814 (9th Cir., 1962); *Eisenschiml* v. *Fawcett Publications*, 246 F.2d 598, 603 (7th Cir., 1957), *cert. denied*, 355 U.S. 907; *Chamberlin* v. *Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir., 1945); *R. C. A. Mfg. Co.* v *Whiteman*, 114 F.2d 86, 90 (2d Cir., 1940), *cert. denied*, 311 U.S. 712; *Guthrie* v. *Curlett*, 36 F.2d 694, 696 (2d Cir., 1929); *Dymow* v. *Bolton*, 11 F.2d 690, 691 (2d Cir., 1926); *Emerson* v. *Davies*, (1845) 8 Fed. Cas. 615, 618-621 (Story, Justice). The protection of ideas exists, if at all, in patent legislation. *Mazer* v. *Stein, supra*, 347 U.S. 201. Hence the term "art" is used in a generic and not qualitative sense: the article to be copyrighted need not constitute a substantive advance in a concept, but it is sufficient if it is an expression of a concept already in existence.

The reason for the distinction between idea and expression is basic to the difference between patent and copyright laws. Patents require a considerable amount of novelty not required by copyrights. *Mazer* v. *Stein*, 204 F.2d 472, 474 (4th Cir., 1953), *aff'd.* 347 U.S. 201; *Baker* v. *Selden, supra*, 101 U.S. 99; *Wheaton* v. *Peters*, 33 U.S. (8 Peters 591) 223, 234; *Thomas Wilson & Co.* v. *Irving Dorfman Co.*, 433 F.2d 409, 411 (2d Cir., 1970), *cert. denied*, 401 U.S. 977; *Gelles-Widmer Co.* v. *Milton Bradley Co.*, 313 F.2d 143, 146 (7th Cir., 1963), *cert. denied*, 373 U.S. 913; *National Comics Publication* v. *Fawcett Publications, Inc.*, 191 F.2d 594, 599 *modified* 198 F.2d 927 (2d Cir., 1951) (L. Hand, *J.*). Patents concern generally ideas,

inventions which can be applied to an indefinite number of applications. *Perris* v. *Hexamer*, 99 U.S. 674 (1878). Copyrights, however, refer to creations which are expressions of ideas. A most basic exposure to the history of art will provide ample proof that while a core concept may remain unchanged, its manifestation in artistic work varies sharply with its cultural and historical surroundings. This is readily apparent in the commercial context: today's fashions are tomorrow's castaways; yesterday's news is old hat (and need not be tomorrow's history). Although the literary expression of news is copyrightable, the factual subject matter is not. *International News Service* v. *Associated Press*, 248 U.S. 215, 234 (1918); *Chicago Record-Herald Co.* v. *Tribune Ass'n.*, 275 F. 797, 798 (7th Cir., 1921). Thus copyrightable works of art often have value for only a short time span, and are useful in a very limited historical and cultural context. *See, e.g. Millworth Converting Corporation* v. *Slifka, supra*, 276 F.2d 443, 444; *Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1093 (2d Cir., 1974), *cert. denied*, 416 U.S. 986.[14] Consequently, since it is merely the *representation* of ideas which is protected, and that expression is so time-bound (in an historical and cultural context), only a very low standard must be satisfied for a work to pass muster with respect to copyrightability. *Bleistein* v. *Donaldson Lithographing Co., supra*, 188 U.S. 239; *Universal Athletic Sales Co.* v. *Salkeld, supra*, 511 F.2d 904, 908; *Donald* v. *Uarco Business Forms, supra*, 478 F.2d 704, 765; *Thomas Wilson & Co.* v. *Irving J. Dorfman Co.*, 433 F.2d 409, 411 (2d Cir., 1970), *cert. denied*, 401 U.S. 977; *H. M. Kolbe Co.* v. *Armgus Textile Co.*, 315 F.2d 70, 72 (2d Cir., 1963); *Adventures in Good Eating* v. *Best Places to Eat*, 131 F.2d 809, 812 (7th Cir., 1942).

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14 All parties concede that the bank's commercial value is greatly time-bound, because it is marketed with the Bicentennial celebration in mind.

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This time limitation also rationalizes from an operational viewpoint the differences between the patent office and the copyright office. *Weir* v. *Gordon*, 111 F.Supp. 117, 123 (E.D.Mich.), *aff'd*. 216 F.2d 508 (6th Cir., 1954). The patent office provides an elaborate but time-consuming search mechanism designed to prevent infringements or interference and to insure novelty of the idea. The copyright office regulations have no such provisions. Compare 35 U.S.C. Chs. 12 and 13 with 17 U.S.C. and 37 C.F.R. Ch. 1 with 37 C.F.R. Ch. 2. Unless an article does not fall into a copyrightable category it will be entitled to copyright protection if the parties follow the proper procedures.

The primary purpose of copyrights, as mandated by the Constitution, Art. 1, § 8, Cl. 8, is "to promote the Progress of Science and the Useful Arts . . ."; financial reward is secondary. *United States* v. *Paramount Pictures*, 334 U.S. 131, 158 (1947); *Twentieth Century Music Corp.* v. *Aiken*, 500 F.2d 127, 130, n. 6 (3d Cir., 1974), *cert. denied*, 416 U.S. 1067; *Berlin* v. *E. C. Publications, Inc.*, 329 F.2d 541, 543 (2d Cir., 1964), *cert. denied*, 379 U.S. 822; *Continental Casualty* v. *Beardsley, supra*, 253 F.2d 702, 704, *cert. denied*, 358 U.S. 816; *Becker* v. *Loews, Inc.*, 133 F.2d 889, 891 (7th Cir., 1943), *cert. denied*, 319 U.S. 772. Progress in the arts connotes rapid dissemination. A copyright becomes akin to a notice or a claim for priority amongst creditors. The claims can be staked out rapidly so that articles of culturally perishable content can rapidly enter the stream of commerce. Thus it is possible for one valid copyright to infringe upon another valid copyright. *See infra.*

In order for copyright protection to have any commercial meaning in this context, however, the standards relating to infringement must be much higher than those relating to mere copyrightability.

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In *Puddu* v. *Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir., 1971), Judge Friendly pointed out this other distinction so crucial to our analysis. He noted that the standards for determining whether an object is copyrightable differ from the standards applied to determine whether an object infringes upon a copyright. *Cf. Millworth Converting Corporation* v. *Slifka, supra*, 276 F.2d 433; *Alfred Bell & Co., Ltd.* v. *Catalda Fine Arts, Inc., supra*, 191 F.2d 99, 102, 104, n. 2; *Helm* v. *Universal Pictures Co.*, 154 F.2d 480, 488, n. 17 (2d Cir., 1946); *Alva Studios, Inc.* v. *Winniger*, 177 F.Supp. 265, 267 (S.D.N.Y., 1959); See *Universal Athletic Sales Co.* v. *Salkeld, supra*, 511 F.2d 904, 908. The different levels of creativity to be applied to these two situations can be understood from the nature of the interest protected and the means for effectuating that protection, as provided in the statutes and regulations discussed above.

"The test of copyright infringement is whether similarity between the products would lead 'the average lay observer . . . [to] recognize [an] alleged copy as having been appropriated from the copyrighted work.'" *Herbert Rosenthal Jewelry Corp.* v. *Honora Jewelry Co., Inc.*, 509 F.2d 64, 65 (2d Cir., 1974). Hence there can be an infringement if there is a substantial similarity between the items in question. *Id.; Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc., supra*, 490 F.2d 1092, 1093, *cert. denied*, 416 U.S. 986. The infringer must act at his peril, because a truly innocent infringement is unlikely. *Mazer* v. *Stein, supra*, 347 U.S. 201; *H. M. Kolbe Co.* v. *Armgus Textile Co., supra*, 315 F.2d 70, 72. In contradistinction to infringement, an article need only fall into the proper category of articles in order to be copyrightable. Such an article can still constitute an infringement of another copyright. *Weir* v. *Gordon, supra*, 111 F.Supp. 117, 123.

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aff'd. 216 F.2d 508; *e.g. Patterson* v. *Century Productions, Inc.*, 93 F.2d 489, 491 (2d Cir., 1937), *cert. denied*, 303 U.S. 655; *Harold Lloyd Corp.* v. *Witwer, supra*, 65 F.2d 1, 17, *cert. denied*, 296 U.S. 669; *but see American Code Co.* v. *Bensinger*, 282 F. 829, 833 (2d Cir., 1922). The objective is to progress now and, if necessary, litigate later; let the courts determine which party is entitled to damages should it find infringement. In the meantime, the public culture benefits from progress; the issue of who is entitled to profits should not induce rigidity and slowness in industries and fields naturally subject to great flux.

Consequently, for purposes of copyrightability, the issue of whether an article is an object of art or not narrows to a judgment as to fact, and not a judgment of artistic sensibility. *Tennessee Fabricating Co.* v. *Moultrie Manufacturing Co., supra*, 421 F.2d 279, 281, *cert. denied*, 398 U.S. 928; *George Hensher Ltd.* v. *Restawile Ltd.* (1974) 2 All.E.R. 420, 426. The tests imposed for copyrightability, are as indicated by the previous discussion, at best, minimal. Art, for the purposes of copyright law has two requisite elements: creativity and originality. *See: United States* v. *Steffens, supra*, 100 U.S. 82, 94 (dictum); *Emerson* v. *Davies, supra*, 8 Fed.Cas. 615, 618-21; *Donald* v. *Uarco Business Forms, supra*, 478 F.2d 764, 765; *Tennessee Fabricating Co.* v. *Moultrie Manufacturing Co., supra*, 421 F.2d 279, 281, *cert. denied*, 398 U.S. 928; *Drop Dead Co.* v. *S. C. Johnson & Son, Inc.*, 236 F.2d 86, 92 (9th Cir. 1963); *Rushton* v. *Vitale, supra*, 218 F.2d 434, 435; *McIntyre* v. *Double-A Music Corp.*, 179 F.Supp. 160, 162 (S.D.Cal., 1959); *Dunham* v. *General Mills, Inc.*, 116 F.Supp. 152, 154 (D.C.Mass., 1953); Nimmer on Copyrights §§ 191, 192. Creativity can be determined from observing the object itself in comparison with others; originality can be gauged from evaluating the process by which the object was made.

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Creativity in this context means only that the object created be more than a trivial variation from what existed before. This implies a modicum of novelty. It has been said in many cases that novelty is not required in order to satisfy the requirements for copyrightability. *Roth Greeting Cards* v. *United Card Co.*, 429 F.2d 1106, 1109 (9th Cir., 1970); *Donald* v. *Zack Meyer's T.V. Sales and Service*, 426 F.2d 1027, 1029 (5th Cir., 1970), *cert. denied*, 400 U.S. 992; *Peter Pan Fabrics, Inc.* v. *Dixon Textile Corp.*, 280 F.2d 800, 802 (2d Cir., 1960); *Whitol* v. *Wells*, 231 F.2d 550, 553 (7th Cir., 1956); *Mazer* v. *Stein, supra*, 204 F.2d 472, 474, *aff'd.* 347 U.S. 201, 218; *Cf.* J. C. Lahore, Art and Function in the Law of Copyright and Designs, 4 Adelaide L.Rev. 183, 200. There have been some cases to the contrary, however. *See: Rushton* v. *Vitale, supra*, 218 F.2d 434, 435.[15] This apparent conflict can be rationalized, however, to mean that the degree of novelty required for patentability need not be reached for copyrightability. *Thomas Wilson & Co.* v. *Irving J. Dorfman Co., supra*, 433 F.2d 409, 411, *cert. denied*, 401 U.S. 977; *Gelles-Widmer Co.* v. *Milton Bradley Co., supra*, 313 F.2d 143, 146, *cert. denied*, 373 U.S. 913; *Mazer* v. *Stein, supra*, 204 F.2d 472, 474 (4th Cir., 1953), *aff'd.* 347 U.S. 201; *National Comics Publications* v. *Fawcett Publications, Inc., supra*, 191 F.2d 594, 599; *Riker* v. *General Electric Co.*, 162 F.2d 141, 142 (2d Cir., 1947). Since the objects adjudged are cultural commodities, upon which there is often heated debate in a free society, creativity requires only a minor quantum of difference from

15 *Universal Athletic Sales Co.* v. *Salkeld, supra*, 511 F.2d 904; *M. M. Business Forms Corp.* v. *Uarco, supra*, 472 F.2d 1137; *Puddu* v. *Buonamici Statuary, Inc., supra*, 450 F.2d 401, 402; *Dan Kasoff, Inc.* v. *Novelty Jewelry Co.*, 309 F.2d 745, 746 (2d Cir., 1962); *Gerlach-Barklow Co.* v. *Morris Bendien*, 23 F.2d 159, 161 (2d Cir., 1927). See also: *McIntyre* v. *Double-A Music Corp., supra*, 179 F.Supp. 160, 161; *Dunham* v. *General Mills, Inc., supra*, 116 F.Supp. 152, 154.

others before it. After all, cultural progress tends to occur incrementally.

By originality, the *process* of the creation is analyzed, and the item is not subject to copyrightability unless it had been constructed by a process requiring independent skill, labor and judgment of an individual. *United States* v. *Steffens, supra*, 100 U.S. 82, 94 (dictum); *Roth Greeting Cards* v. *United Card Co., supra*, 429 F.2d 1106, 1109; *Scott* v. *WKJG, Inc.*, 376 F.2d 467, 469 (7th Cir., 1967), *cert. denied*, 389 U.S. 832; *Lin-Brook Builders Hardware* v. *Gertler*, 352 F.2d 298, 301 (9th Cir., 1965); *Yale University Press* v. *Row, Peterson & Co.*, 40 F.2d 290, 292 (S.D.N.Y., 1930); *National Institute, Inc.* v. *Nutt*, 28 F.2d 132 (D. Conn., 1928), *aff'd.* 31 F.2d 236, 237 (2d Cir., 1929). *Cf. Columbia Broadcasting System Inc.* v. *Melody Recordings, Inc.*, 44 U.S.L.W. 2026 (N.J. App.); Bergstrom, The Literary and Artistic Work in Copyright, 20 Bull. C.R. Soc. 67, 68-69.

The trial court in the instant case found that physical skill was necessary to produce the Snyder bank. From the record, it appears that witnesses for both parties concede that the sculptor needed special skill, training and knowledge, and independent judgment to create the mold. *See Mazer* v. *Stein, supra*, 204 F.2d 472, 473, *aff'd.* 347 U.S. 201; *Smith* v. *George E. Muelbach Brewing Co.*, 140 F.Supp. 729, 731 (W.D.Mo., 1956). The mold was sculpted independently, from scratch. There was no slavish or mechanical copying. *Shapiro, Bernstein & Co., Inc.* v. *Miracle Record Co., Inc.*, 91 F.Supp. 473, 474 (N.D.Ill., 1950). With this, the requisite of originality was satisfied. The district court went on to find, however, that the Snyder bank was merely a trivial variation from the basic bank in the public domain. Although this court has the power to independently evaluate the presence or absence of the creative element, we decline to do so. It is not necessary that we reach that issue because the Snyder bank satisfies the criteria for copyrightability in order to qualify as a reproduction of a work of art, as discussed in the following section.

III. "Reproduction of Works of Art" and Copyrightability

A reproduction of a work of art must satisfy the same standards for copyrightability as must any work of art. However, it would be self-contradictory to require that the reproduction display the same degree of creativity, when compared to the basic work of art, as if it were a conceptually independent production. The very idea of "reproduction" negates, within copyright law, the idea of an increment of difference inherent to the concept of "non-triviality," necessary to the creativity element. *Peter Pan Fabrics, Inc.* v. *Dan River Mills Inc.*, 295 F.Supp. 1366 (S.D.N.Y., 1969), *aff'd.* 415 F.2d 1067; *H. M. Kolbe Co.* v. *Armgus Textile Co.*, 184 F.Supp. 423 (S.D.N.Y., 1960), *aff'd.* 279 F.2d 555 (2d Cir.). That element—creativity—is supplied by the basic underlying work.

It is still requisite that the second element, originality of process, exist, for a reproduction of a work of art to merit copyright protection. As indicated above, Snyder has met his burden in this respect. Since Snyder's bank is entitled to a copyright, the district court erred in holding that Batlin is likely to prevail. On that basis, the court should have denied the injunction.

IV. Conclusion

At a trial on the merits or, alternatively, at proceedings before United States Customs Service, the parties are free to litigate the factual question of infringement.

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At this juncture, it should be emphasized that the protection which attached to Snyder's work, as with any work, is limited to its creative increment. The greater the increment, the more protection is merited thereby.[16] Thus Snyder is not able to appropriate the exclusive benefit of an article in the public domain, by being the first person to fabricate a slavish copy. In cases such as the instant one, it is the increment of difference from the basic version which is protected. *Axelbank* v. *Rony, supra*, 277 F.2d 314, 317; *Adventures in Good Eating* v. *Best Places to Eat, supra*, 131 F.2d 809, 813, n. 3; *Dorsey* v. *Old Surety Life Ins. Co., supra*, 98 F.2d 872, 873; *American Code Co. Inc.* v. *Bensinger, supra*, 282 F. 829, 834; *G. P. Putnam's Sons* v. *Lancer Books, Inc.*, 239 F.Supp. 782, 785 (S.D.N.Y., 1965); *Continental Casualty Co.* v. *Beardsley*, 151 F.Supp. 28, 32 (S.D.N.Y., 1957), *modified* 253 F.2d 702, *cert. denied*, 358 U.S. 816; *Smith* v. *George E. Muehlbach Brewing Co., supra*, 140 F.Supp. 729, 731. *See Morrissey* v. *Proctor &*

16 This formulation applies equally well to articles using copyrighted materials as an inspiration or base. An author is not able to indefinitely prolong his copyright protection by making periodic changes. That person's copyright on the newer version protects only the creative increment and not the underlying basis after the old copyright expires. 17 U.S.C. §§ 3, 7. Section 3 provides:

> "§ 3. Protection of component parts of work copyrighted; composite works or periodicals
>
> The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title."

See *Caliga* v. *Inter Ocean Newspapers Co.*, 157 F. 186 (2d Cir.), *aff'd.* 215 U.S. 182 (1909); *Heim* v. *Universal Pictures Co., supra*, 154 F.2d 480, 488, n. 17; *Adventures in Good Eating* v. *Best Places to Eat, supra*, 131 F.2d 809, 813; *Harold Lloyd Corp.* v. *Witwer, supra*, 65 F.2d 1, 24, *cert. denied*, 296 U.S. 669; *Andrews* v. *Guenther Pub. Co.*, 60 F.2d 555, 557 (S.D.N.Y., 1932).

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Gamble Co., 379 F.2d 675, 678 (1st Cir., 1967). Snyder has staked out his claim to an adaptation of, or a reproduction of an object of art within the public domain, as he was entitled under the statutes. Batlin, on the other hand, is not prohibited from using the same basic bank as an inspiration for its product and from acquiring a copyright. Moreover, since the basic bank is in the public domain, the bank which Batlin was prohibited from importing does not infringe upon Snyder's design if it avoids pirating those increments which Snyder added to his original production. There may be many ways in which the changes in Batlin's bank can be clearly distinguished from Snyder's changes from the basic bank. *Sunset House Distributing Corp.* v. *Doran*, 304 F.2d 251, 252 (9th Cir., 1962); *Dymow* v. *Bolton, supra*, 11 F.2d 690, 691; *Allegrini* v. *DeAngelis*, 59 F.Supp. 248 (E.D.Pa., 1945), *aff'd.* 149 F.2d 815 (3d Cir.); *Barton Candy Corp.* v. *Tell Chocolate Novelties Corp.*, 178 F.Supp. 577, 581 (E.D.N.Y., 1959). On the merits Batlin may well succeed in making this distinction.

Since the district court based its preliminary injunction upon a finding that the Snyder bank is probably not copyrightable, and we hold otherwise, the injunction is vacated and the cause is remanded for further proceedings not inconsistent with this opinion.

OAKES, *Circuit Judge* (dissenting):

The majority opinion rendered today eviscerates this circuit's line of cases requiring a modicum of originality for copyrightability and in doing so opens the door to copyrights for slavish copies of any object in the public domain. Incidentally to doing so the majority also totally disregards the substantial evidence supporting Judge Metzner's findings that the likelihood that appellants can show

any input of originality to justify their copyright is small since change of material and change in size do not alone render an object copyrightable. The majority opinion cheapens copyrights (and the concept of copyright protection) by making them meaningless, supposedly in the name of "progress in the arts."[1] That opinion refers to the "increment of difference" required to supply copyrightability to works of art, but holds, supra at 6371, that the "very idea of reproduction" per se negates the established copyright law requirement that a nontrivial increment of difference exist in a "reproduction" of a work of art when compared with the work of art upon which it is based. Simultaneously, while allowing copyrightability here with no showing below of an "increment of difference,"[2] and with no explanation of what features constitute this increment, the majority goes on to say that the protection here attached to appellants' plastic toy bank is "limited to its creative increment" or that "it is the increment of difference from the basic version which is protected." *Id.* This seems to me to be judicial doubletalk. From the holding as well as the reasoning by which it is reached, I dissent.

Judge Metzner found that appellee, L. Batlin & Son, Inc., had shown through the testimony of its expert and through cross-examination of appellants' expert that the appellants' plastic bank did not evince the required "originality" to give ultimate probability of entitlement to copyright protection because it displayed "merely trivial variations" from the well-known antique metal bank now in the public

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1 The constitutional clause authorizing Congress to enact patent and copyright legislation is "To promote the Progress of Science and useful Arts . . . ." U.S. Const. art. I, § 8(8).

2 The majority states, *supra* at 6370-71, that "[a]lthough this court has the power to independently evaluate the presence or absence of the creative element, we decline to do so. It is not necessary that we reach that issue . . . ."

domain from which or from a modern copy of which it was copied, relying, among other authorities, on *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951), and 1 M. Nimmer, The Law of Copyright § 20.3 (1975 ed.). The majority has come to the novel conclusion that "the requisite of originality was satisfied" merely because the district court found that "physical skill" was necessary to create the plastic bank and because, in the majority's view of the record, the person hired to sculpt the plastic mold needed "special skill, training and knowledge, and independent judgment." *Supra* at 6370. The majority evidently views the requirement that the bank be more than a "trial variation" from the metal bank as part of the "creativity" requirement for works of art which does not apply to reproductions of works of art. Unfortunately, it is clear from the cases that the "trivial variation" standard is the heart of the *originality* requirement for both categories of works. Judge Metzner was entirely correct in concluding that appellants' argument that physical artistic skill was used in the production of the plastic bank fell short of making the required showing that the work displayed substantial variations from the metal bank.

The majority, in fashioning its unprecedented test that mere special skill and independent judgment suffice for originality in even the only trivially variant products, ignores the substantial evidence that comparatively small artistic skill and little independent judgment was involved in making the plastic bank, other than that skill and judgment required to transfer the metal design into the plastic medium with alterations dictated by the use of a different medium. The quality of artistic labor involved may be a relevant indicator of originality, but appellants' expert indicated that the time required to create the plastic work was a day and a half or two at most. Even where courts

have emphasized extraordinary skill and effort as buttressing a finding of originality, these qualities have been characterized in glowing phrases which are distinctly inapposite here. *See Millworth Converting Corp.* v. *Slifka,* 276 F.2d 443, 444 (2d Cir. 1960) (fabric designer effort required one month of work to give three-dimensional color effect to flat surface); *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc., supra,* 191 F.2d at 104-05 n.22 (mezzotint engraver's art requires "great labor and talent"); *Alva Studios, Inc.* v. *Winninger,* 177 F. Supp. 265, 267 (S.D.N.Y. 1959) (exact miniature of Rodin's Hand of God required "great skill and originality").

The polestar test of originality appeared in *Chamberlain* v. *Uris Sales Corp.,* 150 F.2d 512, 513 (2d Cir. 1945):

> The first question with which we must deal is that of the validity of the copyright . . . . Plaintiff [seeking infringement damages] therefore must lose unless he has shown that his work contains some substantial, not merely trivial originality and that defendant sold copies embodying the original aspects of his work.

This test was further elaborated in the leading case of *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc., supra,* 191 F.2d at 102-03, where Judge Frank said that "[a]ll that is needed . . . is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'"[3] This has been echoed in case upon

3 It should, perhaps, be reemphasized that Judge Frank's opinion was issued in the context of upholding copyrights on mezzotints taken from paintings; he quotes at length from a description of the engraver's work, by which effects are produced "by the management of light and shade . . . produced by different lines and dots . . . ." means "very different from those employed by the painter or draughtsman from whom he copies . . . ." *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.,* 191 F.2d 99, 104-05 n.22 (2d Cir. 1951). A mezzotint by its nature cannot be a "slavish copy." Originality found by a trial judge on substantial evidence was thus upheld.

case in this circuit and elsewhere as a requirement of originality.[4] To support a copyright, "a copy of something in the public domain" must present a "distinguishable variation." *Gerlach-Barklow Co.* v. *Morris & Bendien, Inc.,* 23 F.2d 159, 161 (2d Cir. 1927).

Although the originality requirement may be minimal, this "does not prevent the court from concluding as a matter of fact that works may lack even the modicum of originality required." *Gardenia Flowers, Inc.* v. *Joseph Markovits, Inc.,* 280 F. Supp. 776, 782 (S.D.N.Y. 1968). Here, the appellants' plastic bank was admittedly sculpted into plastic using the more costly, metal Uncle Sam bank in the public domain as a model.[5] Even if "[o]riginality in this context 'means little more than a prohibition of actual

4 *See Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.,* 490 F.2d 1092, 1094 (2d Cir. 1974); *Puddu* v. *Buonamici Statuary, Inc.,* 450 F.2d 401, 402 (2d Cir. 1971); *Millworth Converting Corp.* v. *Slifka,* 276 F.2d 443, 445 (2d Cir. 1960); *Consolidated Music Publishers, Inc.* v. *Hansen Publications, Inc.,* 339 F. Supp. 1161, 1162-63 (S.D.N.Y. 1972); *Pantone, Inc.* v. *A.I. Friedman, Inc.,* 294 F. Supp. 545, 547 (S.D.N.Y. 1968); *Gardenia Flowers, Inc.* v. *Joseph Markovits, Inc.,* 280 F. Supp. 776 (S.D. N.Y. 1968).

5 That the plastic bank was copied from the metal bank in virtually every detail was apparent to the experts, to the trial judge, and also from the exhibits submitted, to this writer as well; each has the same number of stars on Uncle Sam's hat, the same number of coat buttons, the same overall color scheme down to the green umbrella in his left hand, the same carpetbag opening the same way, the word "BANK" on the side of the base, an eagle facing right on the front of the base, etc., etc. It is apparent from a cursory reading of contemporary catalogs that metal copies of the originally patented but presently public domain metal banks are on the commercial market without the copyrighting of any of these products having come to the district court's or to our attention. *See, e.g.,* catalog of The Gallery (Amsterdam, N.Y., 1974), at 1, 20; catalog of Carol Ann Gifts (Philadelphia, Pa., 1975) at 12, 22. Why a plastic rendition of the same idea and same expression is now entitled to copyright is hard to fathom. Presumably the metal moldmaker's "special skill, training and knowledge, and independent judgment" are in the same plane as the plastic sculptor's here involved. Does the majority opinion therefore permit a copyright to the metal copyists?

copying,'" *Rushton* v. *Vitale*, 218 F.2d 434, 435 (2d Cir. 1955), here we have just that.

The plastic bank's variations from the original or the up-dated version of the original also in the public domain consist essentially of three: a reduction in size from eleven to nine inches in height; the use of leaves instead of arrows in the clutches of the eagle at the base; and the joining of Uncle Sam's trousers at the ankle. But even the appellants' expert conceded that the steps performed in the copying of the metal bank into reduced plastic size involved changing some of the designs "in order to fit plastic." The district court refused to dignify these changes as an author's contribution of more than "trivial variation" and consigned the plastic bank to the class of items "slavishly copied" and undeserving of copyright protection. In doing so, Judge Metzner, an experienced district judge with more than a passing acquaintance with the arts, was clearly correct. As he stated,

> I am making a finding of fact that as far as I'm concerned, it is practically an exact copy and whatever you point to in this [sic] differences are so infinitesimal they make no difference.

The majority decision, as I have said, cheapens copyrights by making them meaningless. If no originality in terms of variation, but only "physical skill" and "special training" by the author, need be shown as the opinion holds, anyone can copyright anything, calling it a "reproduction of a work of art." The majority, as if to back away from the purport of its decision, then goes on to say rather ambiguously that the protection afforded by the copyright it upholds on the appellants' plastic work is "limited to its creative increment." With no identification of either original or creative "increment" of variation, the

protection afforded appellants' reproduction is theoretically zero.

The majority has thus created an irreconcilable incongruity of implication in its holdings. As Nimmer points out,

> Finally, it should be noted that copyright in a work of art protects against any substantial copying of the work per se, while copyright in a reproduction of a work of art protects only against the copying of the distinctive features contributed by the copyright owner of the reproduction.

1 M. Nimmer, *supra* § 20.3, at 95. Since the majority holds that the plastic work qualified as a "reproduction" without the necessity of possessing "distinctive features," the work has no features to be protected, and its copyright is worthless. Since the majority also implicitly holds that the skill necessary to recreate the work in plastic in slightly reduced size is a sufficiently "original" attribute, it may be that the majority has given appellants simultaneously total monopolistic protection against all competitors in the plastic medium. This is but one example of the bizarre contradictions which flow from the majority's treatment of the concept of "non-triviality" as absent in the "originality" requirement.

One could argue, I suppose, that this decision simply carries *Mazer* v. *Stein*, 347 U.S. 201 (1954), to its logical, if disputable,[6] conclusion. But even while that case held

---

6 *Mazer* v. *Stein*, 347 U.S. 201 (1954) (statuette of Balinese dancer copyrightable despite intended use as base for table lamp), has not been without scholarly criticism. *E.g.*, Comment, *Copyright Protection for Mass-Produced Commercial Products: A Review of the Developments Following* Mazer v. Stein, 38 U. Chi. L. Rev. 807 (1971). *But cf.* Note, *Constitutional Limits on Copyright Protection*, 68 Harv. L. Rev. 517 (1955).

In recognizing that "the initial burden of excluding commonplace

that the statutory terms "works of art" and "reproduction of works of art"—clearly broader than the earlier term "works of the fine arts"—permit copyright of lamp-base statuettes, the Court expressly held that the objects to be copyrightable "must be original, that is, the author's tangible expression of his ideas." 347 U.S. at 214. No such originality, no such expression, no such ideas here appear. It is, I think, not insignificant that the *Mazer* majority cited for this proposition *Burrow-Giles Lithographic Co.* v. *Sarony*. 111 U.S. 53 (1884), which said:

> It is, therefore, much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved, than in the case of a patent right.

Id. at 59-60. Whatever the validity of this as a proposition of law, the citation to it speaks in clarion tones to the element of originality missing here, as it is in the majority's analysis.

I will admit that some of our fabric design cases have gone far in upholding on an ad hoc basis copyrights of design copies on a "minimal quantum of originality," but this has been only "where the design printed is itself unmistakably original" and could be filed itself as a "work of art" under Section 5(g) of the Copyright Act, 17 U.S.C. § 5(g). *Soptra Fabrics Corp.* v. *Stafford Knitting Mills, Inc.*, 490 F.2d

---

matters in the public domain, such as ideas, from copyright status has been left solely to the originality requirement . . . [which] does not perform this function very effectively," the Chicago writer has suggested removing the protection of mass-produced commercial articles entirely from the copyright system. Comment, *supra*, at 812, 823. I need not agree with the suggestion to agree with his conclusion that "[i]n any event . . . they [the articles] should be judged on their own merits." *Id.* at 823. The majority decision leaves us no standard for judging.

1092, 1094 (2d Cir. 1974); *see also Peter Pan Fabrics, Inc.* v. *Dan River Mills, Inc.*, 295 F. Supp. 1366 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (1969). It has not been suggested by anyone that the original Uncle Sam bank or the modern metal copy from which appellants' plastic copy was copied, can be copyrighted at this late date.

In the forest of copyright cases referred to by the majority, the progenitor tree of originality has, I fear, been overlooked.

I would affirm the grant of the preliminary injunction.

APPENDIX C

Opinion of the United States District Court for the Southern District of New York (May 12, 1975)

L. Batlin & Son, Inc.,

Plaintiff,

v.

Jeffrey Snyder, d.b.a. JSNY, *et al.*,

Defendants.

No. 75 Civ. 2036.

United States District Court,
S. D. New York

May 12, 1975

Jacobs & Jacobs, New York City, for plaintiff; Mark H. Sparrow, New York City, of counsel.

Ostrolenk, Faber, Gerb & Soffen, New York City, for defendants Jeffrey Snyder, d. b. a. JSNY, Etna Products Co., Inc.; Robert C. Faber, New York City, of counsel.

Paul J. Curran, U. S. Atty., Southern District of New York New York City, for United States Customs Service; Patrick Barth, Asst. U. S. Atty., of counsel.

Appendix C

Metzner, District Judge:

Plaintiff in this action moves for a preliminary injunction to compel defendants Jeffrey Snyder, doing business as JSNY, and Etna Products, Inc., to cancel the recordation of Copyright No. GP95881 with defendant United States Customs Service, thereby allowing the entry of plaintiff's product into this country.

At the evidentiary hearing on the motion, the court was shown a cast iron "Uncle Sam Mechanical Bank," admittedly in the public domain, and defendants' plastic version of the bank on which they have a copyright. The latter reproduces the former except that it proportionally reduces the height from approximately eleven inches to approximately nine inches with trivial variations. Plaintiff manufactures outside the United States an identical plastic bank which, it is alleged by defendants, infringes their valid copyright, and which is presently in the process of being shipped into this country in quantity.

In copyright cases, the standard for granting a preliminary injunction is a clear showing of probability of success on the merits. Robert Stigwood Group Ltd. v. Sperber, 457 F.2d 50 (2d Cir. 1972); Concord Fabrics, Inc. v. Marcus Brothers Textile Corp., 409 F.2d 1315 (2d Cir. 1969); Uneeda Doll Co. v. Goldfarb Novelty Co., 373 F.2d 851 (2d Cir. 1967).

I have already held in Etna Products Co., Inc. v. E. Mishan & Sons, 75 Civ. 428 (S.D.N.Y. February 13, 1975) [See Appendix K, p. 75a, infra], that I find little probability that defendants' copyright will be found valid in a trial on the merits. I reaffirm that opinion here.

The court agrees with the legal proposition advanced by the defendants that to support a valid copyright as

a reproduction of a work of art, only originality is required. Gardenia Flowers, Inc. v. Joseph Markovits, Inc., 280 F.Supp. 776 (S.D.N.Y. 1968); Nimmer on Copyrights, § 20.3 (1963).

In Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99 (2d Cir. 1951), in which the court defined originality in a reproduction case, the court stated (at pp. 102-03):

> "'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.' No large measure of novelty is necessary. . . .
>
> . . .
>
> All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed *something more than a 'merely trivial' variation,* something *recognizably* 'his own.' Originality in this context 'means *little more than a prohibition of actual copying.*' No matter how poor artistically the *'author's' addition,* it is enough if it be his own." (Emphasis added.)

There is no question that defendant Snyder is an author within the meaning of the copyright laws. *See* Irving J. Dorfman Co. v. Borlan Industries, Inc., 309 F. Supp. 21 (S.D.N.Y. 1969).

Defendants contend that the concept of originality embraces a mere copying if it requires artistic skill to achieve the finished product. The court agrees that in this case a degree of physical artistic skill was necessary to produce the plastic article. What defendant overlooks is that this artistic skill must *contribute* to the work. It must be more than a *"merely trivial variation."* which is

APPENDIX I

Selected Issues of BNA's Patent, Trademark and Copyright Journal

Reports of the Present Case in BNA's Patent, Trademark and Copyright Journal

In Issue No. 231 dated June 5, 1975, the District Court decision in this case is reported on page A-2 and the case is simply identified in the Table of Contents.

In Issue No. 253 dated November 13, 1975, the first Second Circuit Court of Appeals decision appears on page A-12 of the issue, appears in the Table of Contents and, most important, is highlighted on the cover sheet.

In Issue No. 276 dated April 29, 1976, the *en banc* decision of the Second Circuit Court of Appeals is reported at page A-1 of the issue, is indicated in the Table of Contents and is headlined as the first item in the highlights of that issue.

BNA's PATENT, TRADEMARK & COPYRIGHT JOURNAL

ROUTE TO

Number 231 **June 5, 1975**

HIGHLIGHTS

Commissioner Of Patents Assesses Impact of Patent Revision Measures: In response to request by Senator Hiram Fong (D-Hawaii), C. Marshall Dann, Commissioner of Patents and Trademarks says he believes that there would be no problem in accommodating procedures of Patent Office to provisions of S. 23, but for effect of deferred examination on examining workload. . . . page A-17

Inclusion Of Total-Sales Royalty Provision In License Is Not Patent Misuse: Insertion of total-sales royalty provision in licensing agreement, without evidence of illegal "conditioning" of grant of license on payment of royalties for sale of products not covered by patent is not patent misuse and does not invalidate agreement. . . . page A-3

Prior Common Law Right Does Not Destroy Incontestability Of Registration: Prior use of trademark by distributor of goods will give distributor common law right to use mark, but manufacturer's incontestable registration may not now be cancelled because of prior use. . . . page A-4

Innocent Copyright Infringer Liable For Profit From Infringing Sales: Even though infringement was unintentional and sale of infringing goods was stopped immediately upon receipt of notice from owner of design copyright, infringer is still liable for damages in the amount of net profit from infringing sales. . . . page A-5

Club Owner Is Liable For Copyright Infringement By Lessee's Band: Catering hall owner who hires out portion of premises and benefits from infringing activity is liable for copyright infringement by lessee's band. . . . page A-5

Obligation To Pay For "Basic Concept" Makes Patent Validity Irrelevant: Sales agreement by which one party relinquishes all claims to "basic concept" of yarn processing apparatus in exchange for lump sum and percentage of net sales will be enforced regardless of whether patent on apparatus ever issues or whether patent is valid. . . . page A-8

U.S. Patent Agent's Communication Is Privileged: Even though patent agent is not admitted to practice before any U.S. or state court, his communications with patent applicant or agent representing applicant in another country are protected by attorney-client privilege. . . . page A-10

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Roto-Rooter's claim for relief from trademark infringement and unfair competition by Rotary De-Rooting was denied by the district court on the ground that "there was no evidence of any statistically significant confusion in relation to the value of business done by plaintiffs [Roto-Rooter] . . ., that the name 'Rotary De-Rooting Sewer Service' was not deceptively or confusingly similar to the Roto-Rooter name, and that any person exercising ordinary care could readily distinguish the trade names utilized by the parties."

Judge Godbold reverses:

> [Text] The court appears to have employed an incorrect legal standard, and, when examined under correct standards, plaintiffs' evidence established the likelihood of confusion required by the law of this circuit. * * *
>
> The plaintiffs presented evidence of actual confusion -- under World Carpets the best evidence of likelihood -- by the testimony of four persons who had mistakenly employed defendants although intending to use the service of plaintiffs. The District Court considered their testimony "not statistically significant." However, as this court said in World Carpets, "reason tells us that . . . very little proof of actual confusion would be necessary to prove the likelihood of confusion." 438 F.2d at 489. Additionally, the court found that four persons had "simply made an error" which "resulted from carelessness or inadvertence rather than from any confusing similarity between either the names or the advertisements of the parties." The record does not support this finding, either directly or as an inference. Cross-examination, rather than demonstrating carelessness or inadvertence, showed that the four persons had made their mistakes because of reliance upon the similarity of defendants' name to that of plaintiffs'. This is precisely the type of error that 15 U.S.C. § 1114 seeks to protect against. [End Text]

The district court had also found that Roto-Rooter failed to prove secondary meaning, but Judge Godbold points out that since Roto-Rooter is a registered mark, such proof was unnecessary.

- 0 -

MORE ARTISTIC SKILL IN MAKING COPY
DOES NOT RESULT IN ORIGINAL WORK

The use of artistic skill merely to copy a work does not provide the originality required for copyright purposes. Such artistic skill, says the U.S. District Court for Southern New York, must contribute something to the work and must result in more than a "merely trivial variation" of the copied work. (L. Batlin & Son, Inc. v. Snyder, 5/12/75)

Batlin sought the cancellation of Snyder's copyright on an "Uncle Sam Mechanical Bank" which is a copy of Batlin's bank with only trivial variations.

Judge Metzner begins with the proposition that "to support a valid copyright as a reproduction of a work of art, only originality is required." But, he is unable to find the required degree of originality in Snyder's reproduction:

> [Text] Defendants [Snyder] contend that the concept of originality embraces a mere copying if it requires artistic skill to achieve the finished product. The court agrees that in this case a degree of physical artistic skill was necessary to produce the plastic article. What defendant overlooks is that this artistic skill must contribute to the work. It must be more than a "merely trivial variation," which is all that is present here. The need for artistic skill in the execution of the copy is not sufficient. [End Text]

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Without passing on the merits of the decision, the court rejects Snyder's reliance on Alva Studios, Inc. v. Winninger, 177 F. Supp. 265 (S.D.N.Y. 1959). A one-half size reproduction of Rodin's Hands of God was found to be copyrightable in that case. To Judge Metzner, this case is distinguishable because there was a great deal of "complexity" and skill involved in the reproduction. "Here, no such level of input is reached."

- 0 -

INCLUSION IN LICENSE OF TOTAL-SALES
ROYALTY PROVISION IS NOT PATENT MISUSE

The insertion of a total-sales royalty provision in a licensing agreement, without evidence of illegal "conditioning" of the grant of the license on the payment of royalties for the sale of products not covered by the patent, says the Court of Appeals of Maryland, is not sufficient evidence of patent misuse to invalidate the license agreement. (Mutchnik v. M.S. Willett, Inc., 5/7/75)

Mutchnik, the patentee of a metal table slide, granted an exclusive license to Willett which contained a provision calling for the payment of royalties on any slides sold by the licensee, regardless of whether the items were "those described and claimed in the patent." In this suit to enforce the license agreement, the licensee argued that such a provision constituted patent misuse which rendered the agreement illegal.

The trial court refused to enforce the license agreement, because it felt that the patentee would not have granted the license unless the licensee agreed to the inclusion of the total-sales provision. This was considered an illegal "conditioning" of the grant of the license. In addition, the lower court was of the opinion that the patentee's knowledge of the licensee's investment of its own money in tooling up for the manufacture of the slides indicated an exercise of "leverage" in insisting on the inclusion of the total-sales royalty provision.

Judge Murphy concludes that there is no patent misuse in this case because there is no evidence of any action by the patentee to condition the grant of the license on any basis.

> [Text] The record before us is barren of evidence, or inferences properly to be drawn therefrom, of "conditioning" in the Zenith sense. At the time the licensing agreement was negotiated, no patent had been issued on the Mutchniks' table slide and at most Willett's bargaining position was influenced by the existence of the pending patent application. There is, however, no evidence that the Mutchniks refused to license on any basis other than a total-sales royalty, or overrode any objections which Willett may have had to the provision, or rejected any alternative proposal which Willett may have advanced. In fact, there is no evidence to indicate that the total-sales royalty provision was ever a bone of contention between the parties, much less demanded or insisted upon by the Mutchniks. That the Mutchniks were aware of Willett's $40,000 tooling-up expenses, and knew that a substantial part of this expenditure could be lost unless Willett was licensed to manufacture the table slide, does not justify drawing an inference that the Mutchniks demanded or insisted, as a condition to their execution of the licensing agreement, that the total-sales royalty provision be made a part of it. Nor does the inclusion of the total-sales royalty provision in the licensing agreement constitute evidence of "conditioning" simply because the Mutchniks made known to Willett that it was negotiating with other parties, and refused to negotiating with other parties, and refused to negotiate with Willett except through their attorney. The burden of proving patent misuse - that "conditioning" existed in this case - was upon Willett; it showed nothing more than that the total-sales royalty provision was included in the agreement. Under Zenith, such a showing is plainly not sufficient to demonstrate that Mutchnik used its patent leverage to coerce a promise by Willett to pay royalties on table slides not practicing the learning of the patent.

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BNA's
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ROUTE TO

Number 253 HIGHLIGHTS November 13, 1975

CA10 Says Trademark And Goods It Identifies Are Not Separate Products: U.S. Court of Appeals for Tenth Circuit says Shell Oil Company's trademark is *not* "separate product" from gasoline which it identifies, and accordingly overturns district court ruling that Shell was guilty of illegal tie-in. ... page A-18

"In Commerce" Requirement Must Be Met By Goods, Not Acts Of Customers: Trademark applicant whose business operations are effectively confined to single state by Federal Meat Inspection Act, but who nevertheless maintains that his goods are "in commerce" under Lanham Act because his customers cross state lines, is denied federal registration. ... page A-1

Second Circuit Bitterly Divided on "Creativity" Necessary For Copyright: "Creativity" is not required to obtain copyright for reproduction of work of art. Element of creativity, says majority, "is supplied by the basic underlying work." Dissent says majority opinion "eviscerates this circuit's line of cases requiring a modicum of originality for copyrightability and in doing so opens the door to copyrights for slavish copies of any object in the public domain." ... page A-12

Formula Not Generally Known And Not Readily Discernable Is Trade Secret: "Formulation, discovered with difficulty and not generally known nor readily discernible, which had potential commercial value, which was only partially revealed and then in the context of a confidential relationship, and which was otherwise protected in every reasonable manner," is protected under North Carolina common law of unfair competition against misappropriation. ... page A-5

JPML Clarifies Transfer Policy In Patent Cases: Possibility of collateral estoppel will militate against transfer of patent case where another action is "proceeding expeditiously" or "where a very bare minimum number of actions are involved." ... page A-4

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We must agree with [opposer] that [applicant] should not be permitted to register a mark that is nearly identical [The only difference in the letter arrangement of the two marks involves the transposition of the letters "ES" in ALLEREST to "SE" in ALLERSET.] to appellant's mark and use that mark in the same general field of allergy medicines to obtain the benefit of appellant's good will. See Meyer Chemical Co. v. Anahist Co., 46 CCPA 784, 263 F.2d 344, 120 USPQ 483 (1959).

Furthermore, in determining likelihood of confusion, the goods described in appellee's application for registration must be compared with those enumerated in the registration of the opposer's previously registered mark. * * * In this connection, we note that the goods described in opposer's registration are "medication for relief of sinus passage congestion, allergies and hay fever." In our opinion, this description includes not only over-the-counter non-prescription items such as those which appellant presently produces and sells, but also prescription medications for the relief of sinus passage congestion, allergies, and hay fever. [End Text]

Although physicians as a group may be sophisticated purchasers, Judge Baldwin thinks this consideration is "more than outweighed in importance" by a need to avoid likelihood of confusion where both products are used in the same general field, i.e. the treatment of allergies.

The Dissent

Speaking for himself and Judge Rich, Judge Miller's does not agree that the two marks are "nearly identical." He feels that they are "clearly not similar" in sound and meaning. Though both marks include the prefix "Aller," generically indicating allergies as the field of use, the suffixes differ. Appellant's suffix connoting "rest," or "arrest" from allergy, whereas appellee's suffix "set" describes to doctors a prescription allergen injection set.

The dissent views medical doctors as the primary channel of trade through which the parties' goods are marketed, since they purchase or prescribe and use the set to treat their allergy patients. No evidence is adduced to show that physicians are likely to be confused about the source of applicant's products. In fact, Judge Miller asserts that because of their professional training and experience, physicians would be likely to concentrate on the meanings of the marks and unlikely to be confused. As for patient confusion, this is unlikely since purchase is limited to the prescription provided by his medical doctor.

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SECOND CIRCUIT BITTERLY DIVIDED ON "CREATIVITY" NECESSARY FOR COPYRIGHT

Parties trying to cash in on the Bicentennial with toy banks modeled after "Uncle Sam" have set off some spectacular copyright fireworks at the U.S. Court of Appeals for the Second Circuit. In the face of a scathing dissent accusing the court of "judicial doubletalk" that "cheapens copyrights," the majority holds that "creativity" (i.e., something more than a trivial distinction) is not required to obtain a copyright for a reproduction of a work of art. Creativity, says the majority, "is supplied by the basic underlying work." (L. Batlin & Son, Inc. v. Snyder, 10/24/75)

The copyright owner (Snyder) had a sculptor make a plastic, scaled-down replica of a cast iron Uncle Sam bank that passed into the public domain in the early 1900's. When a competitor (Batlin) began to import allegedly infringing banks, the copyright owner threatened suit and also had the U.S. Customs Service bar entry of the competitor's banks into this country.

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The competitor filed a declaratory judgment action seeking to invalidate the copyright, and also requested a preliminary injunction barring enforcement of the copyright and lifting the Customs Service ban on entry of its goods. The U.S. District Court of Southern New York granted the preliminary injunction because it felt that the competitor was likely to prevail on the merits of its copyright invalidity claim. While acknowledging that some artistic skill was required to make the replica, the court said that such skill did not "contribute" to the work and did not amount to more than a "merely trivial variation." See 394 F. Supp. 1389, 187 USPQ 91 (SDNY 1975), 231 PTCJ A-2.

The Second Circuit reverses. (Judge Meskill writes the majority opinion on behalf of himself and Judge Van Graafeiland; Judge Oakes dissents.) the "fact that an idea is in the public domain does not render an expression of that idea uncopyrightable," says the majority. "We must determine whether Uncle Sam can ever attain the status of art, or forever be condemned to an ignoble and unprotected commercial status."

The majority says that copyrightablity must be assessed in light of 17 U.S.C. §5 (g) ("works of art") or 17 U.S.C. §5 (h) ("reproductions of a work of art"). Though registration was obtained under §5 (g) in this case, and registration under §5 (h) might have been more appropriate, "a mistake in designation of the appropriate subsection of the law in the application is not fatal." If the object "falls into any other category of copyrightable items, it is protected nevertheless." Thus, "the instant appeal presents the question of * * * whether this reproduction of a work in the public domain is a fit subject for protection under the copyright laws as a work of art, or as a reproduction of a work of art."

After a lengthy discussion, the majority declines to rule on the "work of art" question, but concludes that the copyright is valid as a "reproduction of a work of art." According to the majority, the objective of the copyright laws is to insure "progress now." If necessary, the parties can "litigate later." A copyright is "akin to a notice or a claim for priority amongst creditors"; the "claims can be staked out rapidly so that articles of culturally perishable content can rapidly enter the stream of commerce." While it may be easy to "stake" or file the claim, however, different standards govern enforcement. "[T]he standards relating to infringement [are] much higher than those relating to mere copyrightability."

Directing its attention to copyrightability alone, the majority says the standards are "minimal," at best. "Art, for the purposes of copyright law has two requisite elements: creativity and originality." The issue of whether or not an object is a work of art "narrows to a judgment as to fact, and not a judgment of artistic sensibility."

[Text] Creativity can be determined from observing the object itself in comparison with others; originality can be gauged from evaluating the process by which the object was made.

Creativity in this context means only that the ojbect created be more than a trivial variation from what existed before. This implies a modicum of novelty. It has been said in many cases that novelty is not required in order to satisfy the requirements for copyrightability. * * * There have been some cases to the contrary, however. * * * This apparent conflict can be rationalized, however, to mean that the degree of novelty required for patentability need not be reached for copyrightability. * * *

* * *

By originality, the process of creation is analyzed and the item is not subject to copyrightability unless it had been constructed by a process requiring independent skill, labor and judgment of an individual.

* * *

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The trial court in the instant case found that physical skill was necessary to produce the * * * bank. From the record, it appears that witnesses for both parties conceded that the sculptor needed special skill, training and knowledge, and independent judgment to create the mold. * * * The mold was sculpted independently, from scratch. There was no slavish or mechanical copying. * * * With this, the requisite of originality was satisfied. The district court went on to find, however, that the * * * bank was merely a trivial variation from the basic bank in public domain. Although this court has the power to independently evaluate the presence or absence of the creative element, we decline to do so. It is not necessary that we reach that issue because the * * * bank satisfies the criteria for copyrightability in order to qualify as a reproduction of a work of art * * *.

A reproduction of a work of art must satisfy the same standards for copyrightability as must any work of art. However, it would be self-contradictory to require that the reproduction display the same degree of creativity, when compared to the basic work of art, as if it were a conceptually independent production. The very idea of "reproduction" negates, within copyright law, the idea of an increment of difference inherent to the concept of "nontriviality," necessary to the creativity element. Peter Pan Fabrics, Inc. v. Dan River Mills Inc., 295 F. Supp. 1366 (S.D.N.Y., 1969), aff'd. 415 F.2d 1067; H.M. Kolbe Co. v. Armgus Textile Co., 184 F. Supp. 423 (S.D.N.Y., 1960), aff'd. 279 F.2d 555 (2d Cir.). That element -- creativity -- is supplied by the basic underlying work.

It is still requisite that the second element, originality of process, exist, for a reproduction of a work of art to merit copyright protection. As indicated above, [the copyright owner] has met his burden in this respect. Since [the] bank is entitled to a copyright, the district court erred in holding that [the competitor] is likely to prevail. On that basis, the court should have denied the injunction.

* * *

At a trial on the merits or, alternatively, at proceedings before United States Customs Service, the parties are free to litigate the factual question of infringement. [End Text]

Having dispensed with any additional "creativity" requirement (beyond that supplied by the underlying work) for a reproduction of a work of art, the majority emphasizes that the protection available to the copyright owner with regard to infringement will nevertheless be limited to the "creative increment" he has supplied; the "greater the increment, the more protection is merited thereby."

[Text] At this juncture, it should be emphasized that the protection which attached to [the copyright owner's] work, as with any work, is limited to its creative increment. * ** Thus, [the copyright owner] is not able to appropriate the exclusive benefit of an article in the public domain, by being the first person to fabricate a slavish copy. In cases such as the instant one, it is the increment of difference from the basic version which is protected. * * * [The copyright owner] has staked out his claim to an adaptation of, or a reproduction of an object of art within the public domain, as he was entitled under the statutes. [The competitor] on the other hand, is not prohibited from using the same basic bank as an inspiration for its product and from acquiring a copyright. Moreover, since the basic bank is in the public domain, the bank which [the competitor] was prohibited from importing does not infringe upon [the copyrighted] design if it avoids pirating those increments which [the copyright owner] added to his original production. There may be many ways in which the changes in [the competitor's] bank can be clearly distinguished from [the copyright owner's] changes from the basic bank. * * * On the merits [the competitor] may well succeed in making this distinction. [End Text]

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Dissent

"The majority opinion," says Judge Oakes, "eviscerates this circuit's line of cases requiring a modicum of originality for copyrightability and in doing so opens the door to copyrights for slavish copies of any object in the public domain." He agrees with the trial court that the "likelihood * * * is small" that the copyright owner could show "any input of originality * * * since change of material and change in size do not alone render an object copyrightable." In short, he says, the majority opinion "cheapens copyrights (and the concept of copyright protection) by making them meaningless."

[Text] [the majority] refers to the "increment of difference" required to supply copyrightability to works of art, but holds * * * that the "very idea of reproduction" per se negates the established copyright law requirement that a nontrivial increment of difference exist in a "reproduction" of a work of art when compared with the work of art upon which it is based. Simultaneously, while allowing copyrightability here with no showing below of an "increment of difference," and with no explanation of what features constitute this increment, the majority goes on to say that the protection here attached to appellants' plastic toy bank is "limited to its creative increment" or that "it is the increment of difference from the basic version which is protected." * * *. This seems to me to be judicial doubletalk. From the holding as well as the reasoning by which it is reached, I dissent.

Judge Metzner [the trial judge] found that [the competitor], had shown through the testimony of its expert and through cross-examination of appellants' expert that the appellants' plastic bank did not evince the required "originality" to give ultimate probability of entitlement to copyright protection because it displayed "merely trivial variations" from the well-known antique metal bank now in the public domain from which or from a modern copy of which it was copied, relying, among other authorities, on Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951), and 1 M. Nimmer, The Law of Copyright § 20.3 (1975 ed.). The majority has come to the novel conclusion that "the requisite of originality was satisfied" merely because the district court found that "physical skill" was necessary to create the plastic bank and because, in the majority's view of the record, the person hired to sculpt the plastic mold needed "special skill, training and knowledge, and independent judgment." * * *. The majority evidently views the requirement that the bank be more than a "trivial variation" from the metal bank as part of the "creativity" requirement for works of art which does not apply to reproductions of works of art. Unfortunately, it is clear from the cases that the "trivial variation" standard is the heart of the originality requirement for both categories of works. Judge Metzner was entirely correct in concluding that appellants' argument that physical artistic skill was used in the production of the plastic bank fell short of making the required showing that the work displayed substantial variations from the metal bank.

The majority, in fashioning its unprecedented test that mere special skill and independent judgment suffice for originality in even the only trivially variant products, ignor the substantial evidence that comparatively small artistic skill and little independent ju - ment was involved in making the plastic bank, other than that skill and judgment required to transfer the metal design into the plastic medium with alterations dictated by the use of a different medium. The quality of artistic labor involved may be a relevant indicator of originality, but appellants' expert indicated that the time required to create the plastic work was a day and a half or two at most. Even where courts have emphasized extraordinary skill and effort as buttressing a finding of originality, these qualities have been characterized in glowing phrases which are distinctly inapposite here.

* * *

Even if "[o]riginality * * * 'means little more than a prohibition of actual copying.'" Rushton v. Vitale, 218 F.2d 434, 435 (2d Cir. 1955), here we have just that.

* * *

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If no originality in terms of variation, but only "physical skill" and "special training" by the author, need be shown as the opinion holds, anyone can copyright anything, calling it a "reproduction of a work of art." The majority, as if to back away from the purport of its decision, then goes on to say rather ambiguously that the protection afforded by the copyright it upholds on the appellants' plastic work is "limited to its creative increment." With no identification of either original or creative "increment" of variation, the protection afforded appellants' reproduction is theoretically zero.

The majority has thus created an irreconcilable incongruity of implication in its holdings. As Nimmer points out,

> Finally, it should be noted that copyright in a work of art protects against any substantial copying of the work per se, while copyright in a reproduction of a work of art protects only against the copying of the distinctive features contributed by the copyright owner of the reproduction.

1 M. Nimmer, supra §20.3, at 95. Since the majority holds that the plastic work qualified as a "reproduction" without the necessity of possessing "distinctive features," the work has no features to be protected, and its copyright is worthless. Since the majority also implicitly holds that the skill necessary to recreate the work in plastic in slightly reduced size is a sufficiently "original" attribute, it may be that the majority has given appellants simultaneously total monopolistic protection against all competitors in the plastic medium. This is but one example of the bizarre contradictions which flow from the majority's treatment of the concept of "non-triviality" as absent in the "originality" requirement.

• • •

In the forest of copyright cases referred to by the majority, the progenitor tree of originality has, I fear, been overlooked. [End Text]

- 0 -

CALIFORNIA LAW PRESERVES RIGHT OF REPRODUCTION FOR ARTIST WHO SELLS "FINE ART"

The state of California has enacted a measure that provides that the right to reproduce a work of "fine art" remains in the artist when the work is transferred, unless that right is also transferred. The law becomes effective January 1.

The text of the measure appears below:

[Text]

CHAPTER 952

An act to amend Section 982 of the Civil Code, relating to common law copyright rights.

[Approved by Governor September 22, 1975. Filed with Secretary of State September 22, 1975.]

LEGISLATIVE COUNSEL'S DIGEST

AB 1051, Sieroty. Common law copyright rights.

Existing law does not provide whether common law copyright rights of reproduction are transferred when the owner of such rights transfers a work of art subject of a common law copyright, or whether such rights remain in such owner, in the absence of an agreement between the owner and transferee.

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BNA's PATENT, TRADEMARK & COPYRIGHT JOURNAL

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HIGHLIGHTS

Second Circuit Declares That Trivial Distinctions Can't Support Copyright: Second Circuit previously split 2-1 in holding that "creativity" (something more than trivial distinction) was not required to obtain copyright for reproduction of work of art. Now, following rehearing en banc, court holds (8-1) that "to support a copyright there must be at least some substantial variation, not merely a trivial variation."

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Patent Use On Behalf of U.K. Vests Jurisdiction In Court Of Claims: U.S. Court of Claims rejects Government's argument that court lacks jurisdiction to consider patentee's charges of infringement since United Kingdom ultimately footed bill for communications satellite program. Infringing acts were "undertaken as much for the benefit of the U.S. as for the U.K."

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Substantiality, Not Size Of Patent Rights, Determines Tax Treatment: Patentee who transfers "undivided interest" in "all substantial rights" to his patent is entitled to long term capital gains treatment of proceeds even though he transferred as little as 1% of his interest.

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Marked Disparity In Prices Does Not Avoid Trademark Infringement: Infringement cannot be avoided by selling infringing item at price marked below that of trademarked item. Public confusion is not avoided "because the plaintiff caters to the so-called rich consumer and the defendant to the 'poorer consumer' and the two are not in the same stream of commerce."

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Appendix I

NEWS & COMMENT

BNA's
PATENT, TRADEMARK & COPYRIGHT JOURNAL

SECOND CIRCUIT DECLARES THAT TRIVIAL DISTINCTIONS CAN'T SUPPORT COPYRIGHT

A dramatic turnabout on an important copyright issue has taken place in the U.S. Court of Appeals for the Second Circuit. The court had previously split 2-1 in holding that "creativity" (something more than a trivial distinction) was not required to obtain a copyright for a reproduction of a work of art, 253 PTCJ A-12. Now, however, following a rehearing en banc, the court holds (8-1) that "to support a copyright there must be at least some substantial variation, not merely a trivial variation." (L. Batlin & Son, Inc. v. Snyder, 4/12/76)

Background

Previously, Judge Meskill had written for the majority; Judge Oakes had filed a blistering dissent attacking the majority opinion as "judicial double-talk" that "cheapens copyrights." Switching roles, Judge Oakes now writes for the majority, and Judge Meskill finds himself the lone dissenter. ("many that are first shall be last; and the last shall be the first." Matthew 19:30.)

The dispute involves toy banks modeled after "Uncle Sam." The copyright owner (Snyder) had a sculptor make a plastic, scaled-down replica of a cast iron Uncle Sam bank that had passed into the public domain in the early 1900's. When a competitor (Batlin) began to import allegedly infringing banks, the copyright owner threatened suit and also had the U.S. Customs Service bar entry of the competitor's banks into this country.

The competitor filed a declaratory judgment action seeking to invalidate the copyright, and also requested a preliminary injunction barring enforcement of the copyright and lifting the Customs Service ban on entry of its goods. The U.S. District Court for Southern New York granted the preliminary injunction because it felt that the competitor was likely to prevail on the merits of its copyright invalidity claim. While acknowledging that some artistic skill was required to make the replica, the court said that such skill did not "contribute" to the work and did not amount to more than a "merely trivial variation." See 394 F. Supp. 1389, 187 USPQ 91 (SDNY 1975), 231 PTCJ A-2.

The Second Circuit reversed, saying "it would be self-contradictory to require that the reproduction display the same degree of creativity, when compared to the basic work of art, as if it were a conceptually independent production." "Creativity," said the majority, was "supplied by the basic underlying work." ____F. 2d____, 187 USPQ 721 (CA2 1975), 253 PTCJ A-12. The court subsequently agreed to reconsider the case en banc, 259 PTCJ A-19.

Decision on Rehearing

According to Judge Oakes, "the requirement of originality [cannot] be satisfied simply by the demonstration of 'physical skill' or 'special training' "in the execution of a reproduction of a work of art. "A considerably higher degree of skill is required, true artistic skill, to make the reproduction copyrightable." Therefore, the district court's decision is affirmed and the previous Second Circuit ruling is repudiated.

Whether a copyright is sought for a work of art (17 U.S.C. § 5(g)) or for a reproduction of a work of art (17 U.S.C. §5(h)), the "requirement of substantial as opposed to trivial variation" is the same, says Judge Oakes. "While the quantum of originality * * * may be modest indeed * * * we are not inclined to abandon that requirement, even if * * * we could do so."

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To warrant protection, a "reproduction must contain 'an original contribution not present in the underlying work of art' and be more than a mere copy." If there is a "point in the copyright law pertaining to reproductions at which sheer artistic skill and effort can act as a substitute for the requirement of substantial variation, it was not reached here."

[Text] Appellants [copyright owners] rely heavily upon Alva Studios, Inc. v. Winninger, [177 F. Supp. 265, 123 USPQ 487 (SDNY 1959)] the "Hand of God" case, where the court held that "great skill and originality [were required] to produce a scale reduction of a great work with exactitude." 177 F. Supp. at 267. There, the original sculpture was "one of the most intricate pieces of sculpture ever created" with "[i]nnumerable planes, lines and geometric patterns . . . interdependent in [a] multi-dimensional work." Id. Originality was found by the district court to consist primarily in the fact that "it takes 'an extremely skilled sculptor' many hours working directly in front of the original" to effectuate a scale reduction. Id. at 266. The court, indeed, found the exact replica to be so original, distinct, and creative as to constitute a work of art in itself. The complexity and exactitude there involved distinguishes that case amply from the one at bar. As appellants themselves have pointed out, there are a number of trivial differences or deviations from the original public domain cast iron bank in their plastic reproduction. Thus concededly the plastic version is not, and was scarcely meticulously produced to be, an exactly faithful reproduction. Nor is the creativity in the underlying work of art of the same order of magnitude as in the case of the "Hand of God." Rodin's sculpture is, furthermore, so unique and rare, and adequate public access to it such a problem that a significant public benefit accrues from its precise, artistic reproduction. No such benefit can be imagined to accrue here from the "knock-off" reproduction of the cast iron Uncle Sam bank. Thus appellants' plastic bank is neither in the category of exactitude required by Alva Studios nor in a category of substantial originality; it falls within what has been suggested by the amicus curiae is a copyright no-man's land.

Absent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts--indeed, the constitutional demand, Chamberlin v. Uris Sales Corp., supra--could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work. Even in Mazer v. Stein, supra, which held that the statutory terms "works of art" and "reproduction of works of art" (terms which are clearly broader than the earlier term "works of the fine arts") permit copyright of quite ordinary mass-produced items, the Court expressly held that the objects to be copyrightable, "must be original, that is, the author's tangible expression of his ideas." 347 U.S. at 214. No such originality, no such expression, no such ideas here appear.

To be sure, the test of "originality" may leave a lot to be desired, although it is the only one we have, in that as one scholar has said, the originality requirement does not perform the function of excluding commonplace matters in the public domain from copyright status very effectively. See Comment, Copyright Protection for Mass Produced Commercial Products: A Review of the Developments Following Mazer v. Stein, 28 U. Chi. L. Rev. 807 (1971). In any event, however, the articles should be judged on their own merits, id. at 823, and on these merits appellants' claim must fail. Here as elsewhere in the copyright law there are lines that must be drawn even though reasonable men may differ where. [End Text]

Judge Meskill Dissents

Judge Meskill remains convinced that the copyright owner "has contributed substantially more than a merely trivial variation." The "independent sculpting of the mold" and the "aggregated differences in size and conformation" are sufficient to warrant copyright protection in his estimation.

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[Text] The most obvious differences between the two exhibits in this case are size and medium. While these factors alone may not be sufficient to render a work copyrightable, they surely may be considered along with the other variations. On the other hand, the author's reasons for making changes should be irrelevant to determination of whether the differences are trivial. * * * [E]ven an inadvertent variation can form the basis of a valid copyright. After the fact speculation as to whether [the copyright owner] made changes for aesthetic or functional reasons should not be the basis of decision.

The primary variations between the two banks involve height; medium; anatomical proportions of the Uncle Sam figure, including shape and expression of face; design of the clothing (hat, tie, shirt, collar, trouser); detail around the eagle figure on the platform; placement of the umbrella; and the shape and texture of the satchel. Granting * * * a copyright protecting these variations would ensure only that no one could copy [this] particular version of the bank now in the public domain * * *. In Alva Studios, supra, 177 F. Supp, at 267, where the author produced no distinctive variations of his own in reproducing the Rodin sculpture, the court still found that the reproduction was copyrightable and that infringement was possible; although mere resemblance would not justify a finding of infringement where the principal elements of a design were taken from the public domain, evidence of actual copying would support such a finding.

This approach seems quite in accord with the purpose of the copyright statute--to promote progress by encouraging individual effort through copyright protection. The relatively low standard of originally required for copyrightability is derived from this purpose. The objective is to progress first and, if necessary, litigate the question of infringement later. In the meantime, the public culture benefits from progress; the issue of who is entitled to the profits should not induce rigidity and slowness in industries and fields naturally subject to great flux. [End Text]

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DISCLOSURE MUST BE ENABLING
TO ALLOW PARTY TO MAKE COUNTS

An applicant who seeks to copy claims from another's patent must do more than disclose the broad concept of the invention. Applicant's specification must disclose not only the composition of the claimed laser glass of the counts, says the U.S. Court of Customs and Patent Appeals, it must also be sufficient "as an enabling disclosure of how to make and use the invention of the counts." (Snitzer v. Etzel, 4/8/76)

The appellant, Snitzer, copies the counts from appellee's patent. Count 1 follows:

[Text] In a laser, a solid luminescent sensitive element of optical regenerative configuration and consisting essentially of a clear glass activated with trivalent ytterbium ions to absorb optical pumping energy in the near infrared region at wave-lengths of from 914 to 974 mu and exhibit stimulated emission of radiation in the near infrared region in a waveband of about 6 mu width which has its optical center at 1.015 microns. [End Text]

In an earlier appeal in the case, the CCPA held (59 CCPA 1242, 465 F.2d 899, 175 USPQ 108 (1972)) that Snitzer's disclosure describes the host material (clear glass) and the activating elements (trivalent ytterbium) of the counts, but remanded the case to consider whether Snitzer's disclosure described the terminal portion of the counts relative to pumping energy and radiation emission wavelengths, and whether the disclosure would enable one skilled in the art to practice the invention recited in the counts. The board found that the terminal portion of the counts was not described in the disclosure nor suggested by the prior art and that undue experimentation would be needed to practice the invention. Accordingly, it held Snitzer's disclosure not to be enabling.

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APPENDIX J

Portion of Front Page of New York Law Journal, November 13, 1975

(See Page 75a *infra* for an Enlargment of Article)

New York Law Journal

VOLUME 175—No. 93 NEW YORK, THURSDAY, NOVEMBER 13, 1975 PRICE ONE DOLLAR

U.S. Court Of Appeals
Second Circuit

Copyright — Public Domain — Reproduction — Skill

In Brief...
Decisions of Interest

Illness Forces Douglas to Quit Supreme Court

Developments And Trends In Evidence

Decision May Be of First Impression

Oral Contract Is Ruled Basis For Bringing Stock-Fraud Suit

Court Sees Effort as 'Unmaintainable'

Class Action Barred in Suit Alleging Medical-Malpractice

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APPENDIX J Continued

Excerpt from Article Appearing on Front Page of New York Law Journal, November 13, 1975

(See Page 74a *supra*)

U.S. Court Of Appeals

Second Circuit

Copyright — Public Domain — Reproduction — Skill

A design patent on an iron toy bank was in the public domain when appellant's sculptor remodeled a replica which was cast into a mold. From it, plastic versions were produced. Appellant secured a copyright on his version, claiming it to be a work of art. Appellee's effort to impart his own version was blocked. In his suit, the district court granted a preliminary injunction. The Court of Appeals reversed.

For a reproduction, the primary element of creativity is supplied by the basic underlying work. Appellant proved the second element, the originality, from the sculptor's special skill in creating the mold. OAKES, J., dissents. In the cases referred to by the Court to uphold appellant's copyright, the progenitor tree of originality has been overlooked.

L. BATLIN & SON, INC., plaintiff-appellee, vs. JEFFREY SNYDER, d/b/a J.S.N.Y. and ETNA PRODUCTS CO., INC., defendants-appellants.

Decided October 24, 1975.

Before *Oakes, Van Graafeiland* and *Meskill*, Circuit Judges.

Appeal from an injunction granted by the District Court for the Southern District of New York, Charles M. Metzner, J., restraining appellant Snyder from enforcing his copyright and interfering with the appellee's importation of a possibly infringing toy bank. The district court found that there was a clear showing of probability of success on the merits because the toy bank was with minor variations taken from the public domain and was not copyrightable. (Reported below at ... F.Supp. ....)

Reversed.

Mark H. Sparrow, New York, N.Y. (Jacobs & Jacobs, P.C., New York, N.Y. of counsel), for plaintiff-appellee.

Robert C. Faber, New York, N.Y. (Marc S. Gross, Ostrolenk, Faber, Gerb & Soffen, New York, N.Y. of counsel), for defendants-appellants.

Meskill, C.J. — The appellants, Jeffrey Snyder and Etna Products Co., Inc. (For the sake of convenience, the appellants herein will be referred to collectively as "Snyder"), appeal from a preliminary injunction in favor of the appellee, L. Batlin & Son, Inc. ("Batlin") compelling Snyder to cancel a recordation of a copyright with the United States Customs Service, and restraining him from enforcing that copyright. The District Court for the Southern District of New York (Metzner, J.), based its action granting the injunction upon a finding that the object of the purported copyright was not entitled to that protection. We reverse, and vacate the preliminary injunction.

I. Factual Background

In 1888 a design patent was obtained on an eleven-inch high cast iron mechanical Uncle Sam bank. This bank ("Basic bank") passed into the public domain when the patent protection expired some time prior to 1909. Act of July 8, 1870, c. 230 Sec. 73, 16 Stat. 210, now 35 U.S.C. Sec. 173. In the spring of 1974, Snyder procured a sculptor to model a nine-inch replica of the original bank. The smaller model was transformed into

Continued on page 4, Column 3

BEST COPY AVAILABLE

APPENDIX K

Opinion of the United States District Court for the Southern District of New York in Companion Case *Etna Products Co.* v. *E. Mishan & Sons*

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

ETNA PRODUCTS CO., INC. and JEFFREY SNYDER, doing business under the name and style, J.S.N.Y.,

Plaintiffs,

—against—

E. MISHAN & SONS,

Defendant.

No. 75 Civ. 428

METZNER, D. J.:

Plaintiffs move pursuant to Rule 65 of the Federal Rules of Civil Procedure to preliminarily enjoin defendant E. Mishan & Sons (Mishan) from alleged infringement of plaintiff Jeffrey Snyder's copyright on a novelty mechanical money bank known as "Old Time Uncle Sam Mechanical Bank." Plaintiffs further seek to enjoin certain acts and practices and to stop certain sales allegedly made in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

The bank was originally designed in the middle of the nineteenth century. It was fashioned of cast iron, and when a plunger was pushed a coin placed in Uncle Sam's hand was mechanically deposited into a satchel by his side and thence into a box below. These banks have been frequently reproduced in metal, and when Snyder saw one in 1974 he decided to produce it in plastic for the toy and novelty market. In doing so, he reduced the size of the bank, scaling the height down from eleven inches to nine inches. After having prototypes made, he published the bank (hereinafter the "Snyder Bank"), with copyright notice, on or about October 15, 1974, and received Copyright Registration No. Gp 95881, a class G copyright, on January 23, 1975.

Cursory observation of the Snyder Bank shows that it is extremely similar to the cast iron bank, save in size and material. There are a few other differences, such as the shape of the satchel, and the leaves grasped in the talons of the American Eagle on the base, but these differences are, by all appearances, minor. Plaintiffs argue that the changes made, including the scaling down to smaller size, and the difference in material, all a product of the skill and judgment of Snyder, constitute the sufficient creativity and originality required for a copyright on a work of art. Defendant, of course, contends that the copyright is invalid, as a mere copy.

Plaintiffs allege that Mishan decided to copy the Snyder Bank. Mishan admits that it took a sample of the Snyder Bank, photographed it for Mishan's sales literature, and used it as a sample at a trade show, having first obliterated plaintiff's copyright notice. Defendant, it must be added, has now arranged to have its own bank manu-

factured, and is offering same for approximately half the price of the Snyder Bank.

In this circuit the prerequisites for granting a preliminary injunction are either a clear showing of probable success and possible irreparable harm, or, alternatively, a showing of sufficiently serious questions going to the merits, and a decided tip in the balance of hardships in the movant's favor. *Sonesta International Hotels Corp.* v. *Wellington Associates,* 483 F.2d 247, 250 (2d Cir. 1973); *Checker Motors Corp.* v. *Chrysler Corp.,* 405 F.2d 319 323 (2d Cir.), *cert. denied,* 394 U.S. 999 (1969). In copyright cases, however, the standard is somewhat less, requiring only a showing of reasonable probability of success on the merits. *Robert Stigwood Group Ltd.* v. *Sperber,* 457 F.2d 50 (2d Cir. 1972); *Concord Fabrics, Inc.* v. *Marcus Brothers Textile Corp.,* 409 F.2d 1315 (2d Cir. 1969); *Uneeda Doll Co.* v. *Goldfarb Novelty Co.,* 373 F.2d 851, 852 n. 1 (2d Cir. 1967).

Copyright Infringement

I think that there is serious doubt as to whether plaintiffs can prevail on their infringement claim. In order for the Snyder Bank to be copyrightable, it must possess the requisite originality and creativity.

> "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' Originality in this context 'means little more than a prohibition of actual copying.'" *Alfred Bell & Co.* v. *Catalda Fine Arts, Inc.,* 191 F.2. 99, 102-03 (2d Cir. 1951) (citation and footnotes omitted).

It is apparent that the standard required is not high. *E.g., Peter Pan Fabrics, Inc.* v. *Acadia Company,* 173 F. Supp. 292 (S.D.N.Y. 1956), *aff'd,* 274 F.2d 487 (2d Cir. 1960). However, there are limitations beyond which copyright protection will not be granted. *Gardenia Flowers, Inc.* v. *Joseph Markovits, Inc.,* 280 F. Supp. 776 (S.D.N.Y. 1968).

The cases are legion stating that the basic requirement is that the author of the work add some input which is recognizably his own, and a mark of his originality and creativity. While this is a question of fact to be determined at trial, the likelihood that plaintiffs here can show any such input is small. First, they argue that the change of material, in itself, is sufficient. This is clearly not so. Plaintiffs rely on *Doran* v. *Sunset House Distributing Corp.,* 197 F. Supp. 940 (S.D. Cal. 1961), *aff'd* 304 F.2d 251 (9th Cir. 1962). In that case, however, the author used a completely new concept. The fact that plastic was used was not controlling. It was that the medium was used to express "the *idea* of Santa Claus." *Id.* at 944 (emphasis added). That idea was original, and therefore the copyright was valid. There is no original idea here.

Plaintiffs in their memorandum argue that this is Snyder's idea of Uncle Sam. It is not. This idea is clearly in the public domain, and is the same creative idea that exists in the antique banks.

Plaintiffs further rely on the change of size of the bank. It should be intuitively obvious that change of size in itself is not copyrightable. If that were true, every copyright of a work of art would be meaningless, as anyone could produce it simply by varying the size. Plaintiffs rely heavily on *Alva Studios, Inc.* v. *Winninger,* 177 F.

Supp. 265 (S.D.N.Y. 1959). In that case, validity of a copyright was upheld for a one-half size replica of Rodin's "Hand of God," exact in every detail and aspect, but in a different medium. In upholding the copyright, the court relied on the very special skills of a sculptor which was required to convert such a difficult and unique shape to a different size. There is just no such difficulty involved in producing the Snyder Bank in plastic.

There is no showing of reasonable probability of success on the infringement claim. Thus, the motion for injunctive relief on this issue is denied.

Lanham Act Section 43(a)

Under this section the cases hold that using another's product, or a photograph of that product, to sell one's own goods, where such goods are less expensive and inferior, is actionable under Section 43(a). *Crossbow, Inc.* v. *Dan-Dee Imports, Inc.*, 266 F. Supp. 335, 338-40 and n. 1 (S.D.N.Y. 1967); *National Dynamics Corp.* v. *John Surrey, Ltd.*, 238 F. Supp. 423 (S.D.N.Y. 1963). Defendant admittedly engaged in both of these practices.

Defendant places great reliance on Judge Tenney's view in *Blazon, Inc.* v. *Deluxe Game Corp.*, 268 F. Supp. 416 (S.D.N.Y. 1965). In that case, however, the question decided was that there is no common law cause of action for reverse palming off. The reference by Judge Tenney to Section 43(a) was solely to show the necessity of interstate commerce for jurisdictional purposes. See *American Optical Co.* v. *Rayex Corp.*, 266 F. Supp. 342 (S.D.N.Y. 1966) (Tenney, J.), *aff'd*, 394 F.2d 155 (2d Cir.), *cert. denied*, 393 U.S. 835 (1968).

It is clear that the harm to plaintiffs can be irreparable if, during the bicentennial celebration, sales are allowed to continue based on the false advertising of defendant.

The preliminary injunction shall issue on this claim.

Supreme Court, U. S.
FILED
AUG 9 1976
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-13

JEFFREY SNYDER, d/b/a J.S.N.Y.
and ETNA PRODUCTS CO., INC.,

Petitioners,

—v.—

L. BATLIN & SON, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

MARK H. SPARROW
Counsel for Respondent
521 Fifth Avenue
New York, New York 10017
(212) MU 7-1636

Of Counsel:

ALBERT L. JACOBS, JR.
BRUCE M. COLLINS
JACOBS & JACOBS, P.C.
521 Fifth Avenue
New York, New York 10017

RECORD PRESS, INC., 95 MORTON ST., NEW YORK, N. Y. 10014—(212) 243-5775

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

Opinions Below

The opinion of the District Court for the Southern District of New York [Appendix C to Petition] is reported at 394 F. Supp. 1389. The first opinion of the Court of Appeals for the Second Circuit [Appendix B to Petition] is reported only at 187 USPQ 721. The *en banc* opinion of the Court of Appeals for the Second Circuit [Appendix A to Petition] is reported only at 189 USPQ 753.

Jurisdiction

The jurisdictional requisites are adequately set forth in the Petition.

Question Presented

This case originates from a decision in the district court granting respondent a preliminary injunction against the enforcement of petitioners' copyright. The court held that there was "little probability" that petitioners' copyright "will be found valid in a trial on the merits." The court below agreed with the district court and affirmed the judgment granting the preliminary injunction. Therefore, the only question presented is:

Was it an abuse of discretion for the district court, based on the record before it, to grant a preliminary injunction against the petitioners' enforcement of their copyright which enforcement was preventing respondent's goods from entering the country?

Statement of the Case

Petitioners' Statement of the Case has omitted several important facts relevant to the Court's consideration of the Petition.

The Procedural Posture of This Case

Respondent, L. Batlin & Son, Inc., brought this action against the petitioners, Jeffrey Snyder and Etna Products Co., Inc., for a declaratory judgment declaring Snyder's

copyright* invalid on three grounds, namely, (1) the work purported to be covered by said registration was not originally created, designed or conceived by petitioner, it having been in the public domain for almost one hundred years; (2) petitioner was not the author thereof; and (3) petitioner failed to comply with the notice provisions of the Copyright Act. In addition, respondent sought damages for unfair competition of petitioners in attempting to stop respondent from selling its version of the public domain Uncle Sam Mechanical Bank by threatening respondent with suit and by blocking respondent's importation of said bank by recording their copyright with the Customs Service, and for restraint of trade under the Antitrust Laws by the commission of several unlawful acts.

Respondent was suffering irreparable damage because its goods were being blocked from entry by petitioners' recordation of its copyright with the United States Customs Service. Respondent obtained an Order to Show Cause for a Temporary Restraining Order and a Preliminary Injunction. The Temporary Restraining Order was granted by the United States District Court for the Southern District of New York. It restrained petitioners from enforcing their copyright and compelled cancellation of the recordation thereof with the United States Customs Service. The Preliminary Injunction was granted after a full evidentiary hearing, which was requested by petitioners, before the District Court, which injunction continued in effect the restraints of the Temporary Restraining Order. Petitioners appealed from the grant of the Prelminary Injunction and the United States Court of Appeals for the Second Circuit reversed in an opinion dated October 24, 1975 [Appendix B

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* Copyright No. Gp 95881, "Uncle Sam Bank."

to Petition]. Respondent petitioned the Court of Appeals for a rehearing, requesting such rehearing *en banc,* and said petition was granted in both respects. Upon rehearing *en banc* the Court of Appeals affirmed the District Court, thus vacating its prior decision [Appendix A to Petition].

The Facts of This Case

The respondent, L. Batlin & Son, Inc., has been in business since 1929 and is engaged in the design, importing, and sale of such goods as toys, novelty items, housewares, porcelain, china and glass, which goods are advertised and sold throughout the United States. It has been selling various types of novelty savings banks for at least 20 years.

At the time respondent purchased the plastic reproduction of the Uncle Sam mechanical bank, it had for some time been selling cast iron mechanical banks made in Taiwan, which were replicas of antique American banks, including the Uncle Sam mechanical bank. Shortly after respondent received its first shipment of plastic banks, it was notified by the United States Customs Service that petitioner Jeffrey Snyder had recorded a copyright that allegedly covered the Uncle Sam Bank. Since the Customs Service advised respondent that it would not allow either the plastic *or the cast iron banks* entry, and since respondent had orders to fill and more banks on the water, it brought this action for declaratory judgment and the motion for a temporary restraining order and preliminary injunction.

After Judge Metzner granted respondent's request for a temporary restraining order, the Distrct Court, at the request of the petitioners, held a full evidentiary hearing

before deciding on whether or not to grant a preliminary injunction. For the purposes of the hearing, the only issue considered by the court below was the *probability of respondent's success* in proving petitioners' copyright invalid at a trial on the merits on the ground that petitioners' bank was an unoriginal substantial copy of a work long since in the public domain. The respondent had already posted a bond upon the grant of the Temporary Restraining Order and there was no dispute as to the sufficiency thereof, or the fact that respondent was suffering irreparable injury. The other issues of invalidity due to improper copyright notice and authorship were never reached, the court below stating that, with respect to the ground of lack of originality, there was:

> • • • little probability that defendants' [petitioners'] copyright will be found valid in a trial on the merits. [Appendix C to Petition, p. 45a]

At the evidentiary hearing below, respondent's expert witness stated that there was no degree of originality existing in petitioners' bank over the one which had long been in the public domain, and that whatever differences there were had been made to facilitate the production of petitioners' bank. Petitioners' bank was no more than a direct copy with proportionate changes in size. None of the trivial differences were unique, artistic, or required any degree of originality [Appendix in the Court of Appeals, pp. 53-58, 86].

The only facts presented which related to the making of petitioners' bank are contained in petitioner Snyder's affidavit [Appendix in the Court of Appeals, pp. 36-57]. Although petitioners asked for the evidentiary hearing and

Jeffrey Snyder was present, he never took the witness stand. Indeed, all we are told by Snyder's affidavit is that the manufacturer's representative made some sketches *with the public domain cast iron bank in front of him,* after which the manufacturer "Unitoy had made a clay model * * * *presumably* using the sketches as a guide for this clay model." After some discussion, "Unitoy promised to make a prototype in plastic."

Petitioners refer to Appendix G to Petition, which is a list they compiled of "distinctive features" of their bank. These so-called "distinctive features" were described by the Court of Appeals in its opinion [Appendix A to Petition]:

> Our examination of the banks results in the same conclusions as that of Judge Metzner in Etna Products, the earlier case enjoining Snyder's copyright, that the Snyder bank is "extremely similar to the cast iron bank, save in size and material" with the only other differences, such as the shape of the satchel and the leaves in the eagle's talons being "by all appearances, minor." Similarities include, more importantly, the appearance and number of stripes on the trousers, buttons on the coat, and stars on the vest and hat, the attire and pose of Uncle Sam, the decor on his base and bag, the overall color scheme, the method of carpetbag opening, to name but a few. [pp. 5a to 6a]

Summary of the Argument

Respondent believes that the decision of the court below does not present an issue for review by this Court for the following reasons:

1. The present case involves only the propriety of the granting of a preliminary injunction, based on the record before the district court.

2. The decision below is clearly correct and applied the prevailing law to determine that there is little probability that petitioners' copyright will be found valid in the trial on the merits.

REASONS FOR DENYING THE WRIT

I. The Present Case Involves Only the Propriety of the Granting of a Preliminary Injunction, Based on the Record Before the District Court.

Putting the matter in perspective, it is apparent that the effect of the granting of the preliminary injunction does not decide the issue of copyrightability on the merits, but only involves a question of the proper exercise of judicial discretion. True, the prior decisions by the Court of Appeals discuss the existence of originality as a test for copyrightability. However, in view of the fact that that test is the one which has been used by this Court and the majority of lower courts for at least thirty years, and that

> the sole question on this appeal is whether Judge Metzner abused his discretion in granting Batlin a preliminary injunction [Appendix A to Petition, p. 5a],

the validity of petitioners' copyright registration is not an issue for review by this Court. That issue remains for trial before the District Court.

The issue in the present case is uniquely narrow, and no amount of strained semantics can convert it into one warranting review by this Court on certiorari. The case does not in any sense broadly concern any tests of copyrightability, but rather whether the District Court abused its discretion when it granted respondent a preliminary injunction based on its finding that, upon a trial on the merits, it was *likely* that petitioners' copyright would be held invalid.

Petitioners attempt to show the decisions below received wide notoriety. Actually, the BNA *Journal,* reproduced at Appendix I to Petition, pp. 58a-73a, treated them as it did all other patent, trademark, and copyright matters, including some remarks made by the Commissioner of Patents on pending legislation [pp. 58a]; the New York *Law Journal* felt that the significance of the case was such that it *never* printed the *en banc* decision to inform its readers that the prior decision was vacated, and West Publishing Company has *not* included *either* Court of Appeals' decision in its *Federal Reporter.*

II. The Decision Below Is Clearly Correct and Applied the Prevailing Law to Determine That There Is Little Probability That Petitioners' Copyright Will Be Found Valid in the Trial on the Merits.

Petitioners attempt to demonstrate that the court below erred in finding that there was little probability that petitioners' copyright will be found valid after a trial on the

merits by taking a phrase used by the court, "a higher degree of skill," out of context and promoting that as the sole test upon which the court relied. Nothing could be further from the fact. The court below meticulously examined the authorities and the case law and, under the weight of the same, came to the correct conclusion:

> To be sure, the test of "originality" may leave a lot to be desired, although it is the only one we have, in that as one scholar has said, the originality requirement does not perform the function of excluding commonplace matters in the public domain from copyright status very effectively • • • In any event, however, the articles should be judged on their own merits • • • and on these merits appellants' claim must fail. Here as elsewhere in the copyright law there are lines that must be drawn even though reasonable men may differ where. [Appendix A to Petition, p. 12a]

It is clear that the District Court heeded this Court's oft quoted admonition in *Bleistein* v. *Donaldson Lithographing Co.,* 188 U.S. 239 (1903) concerning the danger if the courts judged the worth of copyrighted works. The District Court did not constitute itself "final judges of the worth" of petitioners' bank. It had before it a designer and modeler as an expert, whom the court questioned very closely [Appendix in Court of Appeals, pp. 55-58].

Although admittedly the sole question on appeal was the proper exercise of judicial discretion, the court below was forced, in its *en banc* decision, to deal with the issue of originality as it effects copyrightability because of the errors in the prior decision of that court. However, simply based on the issue before the district court, and on the evi-

dence before it, the court below correctly restated the prevailing law with respect to the requirment of originality for copyrightability.

Contrary to petitioners' statement, the court below did carefully examine *Mazer* v. *Stein,* 347 U.S. 201 (1954) [Appendix A to Petition, p. 12a] and did specifically distinguish between the requirements of originality for copyrightability and novelty for patentability [Appendix A to Petition, p. 8a]. Moreover, the court went even further, noting in its decision:

> It has been the law of this circuit for at least 30 years that in order to obtain a copyright upon a reproduction of a work of art under 17 U.S.C. §5(h) that the work "contain some substantial, not merely trivial originality • • • " *Chamberlin* v. *Uris Sales Corp., supra,* 150 F. 2d at 513. [Appendix A to Petition, p. 7a]

The District Court, too, was well aware of the current leading decision of the Second Circuit that defined originality, quoting from *Alfred Bell & Co.* v. *Catalda Fine Arts,* 191 F.2d 99 (CA 2, 1951) [Appendix C to Petition, p. 46a]. Moreover, other circuit courts of appeal, too, have adopted the test of *Alfred Bell & Co.* v. *Catalda Fine Arts, supra,* in resolving the question of copyrightability of a work based on a work already in the public domain. After a discussion of the facts in light of that case, as well as *Amsterdam* v. *Triangle Publications, Inc.,* 189 F.2d 104 (CA 3, 1951) and many district court cases, the court in *Donald* v. *Zack Meyer's T. V. Sales and Service et al.,* 426 F.2d 1027 (CA 5, 1970) concluded:

> The Copyright Act was not designed to protect such negligible efforts. We reward creativity and originality with a copyright but we do not accord copyright protection to a mere copycat.

While petitioners' claim that the court below failed to follow the tests for copyrightability as laid down by this Court and the circuit courts of appeal, the sole issue is the propriety of the exercise of judicial discretion. As is apparent from even the briefest review of the decision below, the court strictly followed the prevailing decisions and did not, in any sense, create its own test of originality. What the petitioners really are objecting to is the lower court's refusal to adopt *their* contrived test for copyrightability.

CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be denied.

Respectfully submitted,

MARK H. SPARROW
Counsel for Respondent
521 Fifth Avenue
New York, New York 10017
(212) MU 7-1636

Of Counsel:

ALBERT L. JACOBS, JR.
BRUCE M. COLLINS
JACOBS & JACOBS, P.C.
521 Fifth Avenue
New York, New York 10017